Supreme Court, U.S.
FILED
041566 MAY 19 2005
OFFICE OF THE CLERK

No. _____

In the Supreme Court of the United States

THEIS RESEARCH, INC.,
Petitioner,

v.

BROWN & BAIN
and such present and former Brown & Bain partners, associates, and other personnel responsible for the management and trial of all litigation involving Peter F. Theis and Theis Research, Inc.,
Respondent.

On Petition for a Writ of Certiorari
to the United States Court of Appeals for the Ninth Circuit

PETITION FOR WRIT OF CERTIORARI

PAUL R. JOHNSON
Counsel of Record
ROBERT D. EASSA
FILICE BROWN EASSA & MCLEOD LLP
1999 HARRISON STREET, 18TH FLOOR
OAKLAND, CA 94612
(512) 444-3131

Counsel for Petitioner

Becker Gallagher Legal Publishing, Inc. 800.890.5001

QUESTIONS PRESENTED

Respondent law firm previously represented petitioner in patent litigation that went awry. To comply with an arbitration clause in respondent's legal services agreement, petitioner arbitrated its malpractice claims. The award gave nothing to either side. Petitioner thereafter discovered that respondent had violated state conflict-of-interest law because it had simultaneously represented the integrated subsidiary of an adverse party in the patent litigation.

Petitioner filed this diversity action, seeking to vacate the arbitration award. Petitioner relied on state law holding unlawful contracts void *ab initio* and nullifying embedded arbitration clauses and resulting awards. Petitioner cited additional conflicts disclosed in discovery. The district court nevertheless confirmed the arbitration award and held that petitioner's conflict of interest claims were barred by claim preclusion doctrine. The court of appeals affirmed.

The following questions are presented:

1. Whether courts—as opposed to arbitrators—shall decide challenges to an underlying agreement with an arbitration clause on the ground that the agreement was void and never existed at the outset, in contrast to agreements that are merely voidable.

2. Whether, in a diversity case, state law can render an unlawful underlying agreement, including an arbitration clause and a resulting arbitration award, null and void *ab initio*.

3. Whether, for diversity jurisdiction to review an arbitration award, the amount in controversy is determined by the amount of the award or the amount in issue in the underlying dispute.

PARTIES TO THE PROCEEDING

Rule 14.1(b) Statement: The following lists all parties to the proceeding in the court whose judgment is sought to be reviewed:

Plaintiff-Appellant: Theis Research, Inc., an Illinois corporation

Defendant-Appellee: Brown & Bain, a California and Arizona law firm, and such present and former Brown & Bain partners, associates, and other personnel responsible for the management and trial of all litigation involving Peter F. Theis and Theis Research, Inc.

According to a press release dated June 23, 2004, Perkins Coie LLP and Brown & Bain, P.A., announced that effective July 1, 2004, the two firms would "combine." On July 2, 2004, Brown & Bain served a statement that: "On July 1, 2004, Brown & Bain, P.A., changed its name to Perkins Coie Brown & Bain P.A."

Rule 29.6 Statement: There is no parent or publicly held company owning 10% or more of the stock of petitioner Theis Research, Inc.

TABLE OF CONTENTS

QUESTIONS PRESENTED i

PARTIES TO THE PROCEEDING ii

OPINIONS BELOW 1

JURISDICTION 1

STATUTES INVOLVED 2

STATEMENT OF THE CASE 3

Factual and Procedural Background 5

REASONS FOR GRANTING THE PETITION 15

I. The Conflict among Several Circuits—over Whether Courts, as Opposed to Arbitrators, Shall Decide Challenges to an Underlying Agreement as Null and Void *ab Initio*—Concerns an Important Federal Question That Needs Resolution 15

II. The Conflict—over Whether, in a Diversity Case, State Law Can Render an Unlawful Underlying Agreement Void *ab Initio*, Nullifying the Arbitration Clause and Resulting Award—Concerns an Important Federal Question That Needs Resolution 23

III. Conflict Concerning the Applicable Amount in Controversy for Diversity Jurisdiction to Review an Arbitration Award—Whether the Amount of the Award or the Amount in Issue in the Underlying Dispute—Should Be Resolved 28

CONCLUSION 30

APPENDIX

02/18/2005—United States Court of Appeals for the Ninth Circuit: order amending opinion and denying rehearing petition and petition for rehearing en banc and amended opinion 1a

10/20/2004—United States Court of Appeals for the Ninth Circuit: opinion 16a

08/19/2002— United States District Court for the Northern District of California: judgment 29a

08/06/2002—United States District Court for the Northern District of California: order granting defendant's motion for summary judgment and denying plaintiff's motion for leave to file motion for reconsideration and motion for partial summary judgment 30a

08/28/2001—United States District Court for the Northern District of California: order denying plaintiff's motions for partial summary judgment and to vacate arbitration award and granting defendant's motion to confirm arbitration award 32a

TABLE OF AUTHORITIES

Cases

Alabama Catalog Sales v. Gloria Harris M.Q., Inc.
794 So. 2d 312 (Ala. 2000) 24

All Points Traders, Inc. v. Barrington Associates
211 Cal. App. 3d 723 (1989) 12, 24

Allied-Bruce Terminix Cos. v. Dobson
513 U.S. 265 (1995) 24

Alternative Systems, Inc. v. Carey
67 Cal. App. 4th 1034 (1998) 13, 26-27

Anderson v. Eaton
211 Cal. 113 (1930) 11, 16

Baltin v. Alaron Trading Corp.
128 F.3d 1466 (11th Cir. 1997) 29

Bess v. Check Express
294 F.3d 1298 (11th Cir. 2002) 22, 26

Branson v. Sun-Diamond Growers
24 Cal. App. 4th 327 (1994) 14

Bull HN Information Systems, Inc. v. Hutson
229 F.3d 321 (1st Cir. 2000) 29

Burden v. Check into Cash of Kentucky, LLC
267 F.3d 483 (6th Cir. 2001) 22

Cardegna v. Buckeye Check Cashing, Inc.
894 So. 2d 860 (Fla. 2005) 25

Chambers v. Kay
29 Cal. 4th 142 (2002)..... 11, 16, 24

Citizens Bank v. Alafabco, Inc.,
539 U.S. 52, 56 (2003)..... 26

City Lincoln-Mercury Co. v. Lindsey
52 Cal. 2d 267 (1959)..... 13, 17, 24

Doctor's Associates v. Casarotto
517 U.S. 681 (1996)..... 24

Ficek v. Southern Pacific
338 F.2d 655 (9th Cir. 1964)..... 27

First Options of Chicago, Inc. v. Kaplan
514 U.S. 938 (1995)..... 18, 23

Ford v. Hamilton Investments, Inc.
29 F.3d 255 (6th Cir. 1994)..... 28

Image Technical Service, Inc. v. Eastman Kodak Co.
136 F.3d 1354 (9th Cir. 1998)..... 11, 16

International Assn. of Fire Fighters v. City of San Leandro
181 Cal. App. 3d 179 (1986)..... 13, 17, 24

International Evangelical Church v. Church of the Soldiers etc., 54 F.3d 587 (9th Cir. 1995)..... 13

Iowa Mgmt. & Consultants, Inc. v. Sac & Fox Tribe
656 N.W.2d 167 (Iowa 2003)..... 25

I.S. Joseph Co. v. Michigan Sugar Co.
803 F.2d 396 (8th Cir. 1986)..... 21

Kallen v. Delug
157 Cal.App.3d 940 (1984)..... 16, 24

Lawrence v. Comprehensive Business Services Co.
833 F.2d 1159 (5th Cir. 1987)..... 26

Lindenstadt v. Staff Builders, Inc.
55 Cal. App. 4th 882 (1997)..... 13, 27

Loving & Evans v. Blick
33 Cal. 2d 603 (1949).....12-13, 24-27

Match-E-Be-Nash-She-Wish Band of Pottawatomi Indians v. Kean-Argovitz Resorts
383 F.3d 512 (6th Cir. 2004).....22-23, 26

Microchip Tech. Inc. v. U.S. Philips Corp.
367 F.3d 1350 (Fed. Cir. 2004)..... 21

Morrison Knudsen Corp. v. Hancock, Rothert & Bunshoft, LLP, 69 Cal.App.4th 223 (1999)..... 8

Moncharsh v. Heily & Blasé
3 Cal.4th 1 (1992)..... 12-13, 27

Nature's 10 Jewelers v. Gunderson
2002 S.D. 80, 648 N.W.2d 804 (S.D. 2001) 25

Onvoy, Inc. v. SHAL, LLC
669 N.W.2d 344, 353 (Minn. 2003)..... 20, 25

People ex rel. Department of Corporations v. SpeeDee Oil Change Systems, 20 Cal. 4th 1135 (1999) 11, 16

Prima Paint Corp. v. Flood & Conklin Manufacturing Co.
388 U.S. 395 (1967)..... 17-20, 23

Rosenthal v. Great Western Financial Securities Corp.
14 Cal. 4th 394 (1996)..... 17-18

Sandvik AB v. Advent Int'l Corp.
220 F.3d 99 (3d Cir. 2000) 19-20

Santa Clara County Counsel Attorneys Association v. Woodside, 7 Cal. 4th 525 (1994) 11

Sirotzsky v. New York Stock Exchange
347 F.3d 985 (7th Cir. 2003) 28-29

South Bay Radiology Medical Assoc. v. W. M. Asher, Inc.
220 Cal. App. 3d 1074 (1990) 13, 27

Southland Corp. v. Keating
465 U.S. 1, 12 (1984) 26

Spahr v. Secco
330 F.3d 1266 (10th Cir. 2003) 20

Sphere Drake Ins. Ltd. v. Clarendon Nat'l Ins. Co.
263 F.3d 26 (2d Cir. 2001) 19-20

Theis Research, Inc. v. Brown & Bain
240 F.3d 795 (9th Cir. 2001) 11

Theis Research, Inc. v. Brown & Bain
386 F.3d 1180 (9th Cir. 2004) 1, 15

Theis Research, Inc. v. Brown & Bain
400 F.3d 659 (9th Cir. 2005) 1

Three Valleys Municipal Water District v. E.F. Hutton & Co., 925 F.2d 1136 (9th Cir. 1991) 18-20

United Mine Workers v. Gibbs
383 U.S. 715 (1966) 30

Will-Drill Res., Inc. v. Samson Res. Co.
352 F.3d 211 (5th Cir. 2003) 21-22

Statutes

9 U.S.C. § 2 ..... 2, 4, 15-16, 24, 27

9 U.S.C. § 10 ..... 2, 17, 25

28 U.S.C. § 1254 1

28 U.S.C. § 1332 ..... 2, 5, 28-29

California Code of Civil Procedure § 1281 27

California Code of Civil Procedure § 1288 25

Other Authorities

California Rules of Professional Conduct
Rule 3-310 ..... 11, 16

U.S. District Court, Northern District California
Civil Local Rule 11-4 ..... 11, 16

PETITION FOR A WRIT OF CERTIORARI

Petitioner Theis Research, Inc. (Theis—pronounced "Tice") respectfully prays that a writ of certiorari issue to the United States Court of Appeals for the Ninth Circuit as to its judgment filed and entered October 20, 2004, and amended February 18, 2005.

OPINIONS BELOW

The order amending opinion and denying rehearing petition and petition for rehearing en banc and amended opinion of the United States Court of Appeals for the Ninth Circuit is published at 400 F.3d 659 (9th Cir. 2005). *See* Appendix (App.) at 1a-15a, *infra*. The unamended opinion of the Ninth Circuit (App. at 16a-28a) is published at 386 F.3d 1180 (9th Cir. 2004). The judgment entered August 19, 2002, by the United States District Court for the Northern District of California (App. at 29a) is unpublished, as are the district court's orders of August 6, 2002 (App. at 30a-31a) and August 28, 2001 (App. at 32a-47a).

JURISDICTION

The judgment of the United States Court of Appeals was entered on October 20, 2004, and amended February 18, 2005. *See* App. at 1a, 16a. A petition for rehearing was timely filed and was denied on February 18, 2005. *See* App. at 1a, 4a. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTES INVOLVED

9 U.S.C. § 2 [Federal Arbitration Act]. *Validity, irrevocability, and enforcement of agreements to arbitrate*

A written provision in any maritime transaction or a contract evidencing a transaction involving commerce to settle by arbitration a controversy thereafter arising out of such contract or transaction, or the refusal to perform the whole or any part thereof, or an agreement in writing to submit to arbitration an existing controversy arising out of such a contract, transaction, or refusal, shall be valid, irrevocable, and enforceable, save upon such grounds as exist at law or in equity for the revocation of any contract.

9 U.S.C. § 10 [Federal Arbitration Act]. *Same; vacation; grounds; rehearing*

(a) In any of the following cases the United States court in and for the district wherein the award was made may make an order vacating the award upon the application of any party to the arbitration—

(1) where the award was procured by corruption, fraud, or undue means;

* * *

(4) where the arbitrators exceeded their powers, or so imperfectly executed them that a mutual, final, and definite award upon the subject matter submitted was not made.

* * *

28 U.S.C. § 1332 [Diversity Jurisdiction]. *Diversity of citizenship; amount in controversy; costs*

(a) The district courts shall have original jurisdiction of all civil actions where the matter in controversy exceeds the sum or value of $75,000, exclusive of interest and costs, and is between—

(1) citizens of different States;

* * *

STATEMENT OF THE CASE

There are few examples of corruption more destructive of the justice system than when, as in this case, a law firm that has failed to defend its client's rights in a case is discovered to have been working simultaneously on the payroll of parties on the other side.

A law firm's honest and diligent compliance with the ethical rules—rigorously enforced by the courts—is the public's only systematic protection against conflicts of interest. Where (as here) the client discovers the law firm's conflicts after the fact, it is all the more urgent that courts hold the firm to answer for its ethical violations.

When presented with such a case, the Ninth Circuit has instead set a precedent for overlooking and silently condoning such conduct, corrupting the judicial process.

The Ninth Circuit has decided that even for admittedly meritorious claims of unlawful conflicts of interest, private arbitrators should have the final say in deciding the legality of underlying agreements, even when they undermine the judicial process.[1] Under the Ninth Circuit's opinion, if the private arbitrator does not object, the courts are powerless to do anything about it. *See* App. at 13a.

---

[1] Respondent's admissions of conflicts are referenced below. Though not focused on the unlawfulness of the conflicts, the author of the Ninth Circuit's opinion even admitted during Theis' oral argument that "you made it a fairly persuasive, a persuasive argument, a very good argument, about look, here is this basic misrepresentation in the representation agreement. That renders the agreement void. Therefore, the provision in the agreement calling for arbitration is void."

This abdicates the responsibility of courts to assure the integrity of the judicial process. Worse, it invites law firms to simultaneously represent clients with conflicting interests while concealing such conduct from the client whose representation is compromised by the conflict.

Even though this case was filed as a diversity action in California, the Ninth Circuit refused to follow California Supreme Court precedent holding that courts decide unlawfulness, including any challenge to an arbitration award (as in this case) based on illegality pertaining to the entirety of the underlying agreement. The Ninth Circuit's judgment conflicts with recognized principles of federalism intertwined in the Federal Arbitration Act, 9 U.S.C. § 2.

As discussed in the reasons for granting the petition, the courts of appeals are in conflict over whether courts—as opposed to arbitrators—shall decide whether an underlying agreement (with an arbitration clause) existed in the first place.

Decisions of the Second and Third Circuits and the California Supreme Court (interpreting the Federal Arbitration Act), and a prior Ninth Circuit decision, have distinguished between void (non-existent) underlying agreements and those that are merely voidable. They hold that courts, rather than arbitrators, shall determine whether an underlying agreement is void and thus non-existent. The Eight, Tenth, and Federal Circuits have also determined that it is the role of courts to decide whether an underlying agreement (with an arbitration clause) exists.

In conflict are the Ninth Circuit in this case and other circuits that have rejected the distinction between void and voidable contracts. Decisions of the Fifth, Sixth, and Eleventh Circuits have held that arbitrators should decide whether an underlying agreement is void.

Under decisions by the high courts of at least four states—Alabama, California (applicable here), Florida, and South Dakota—courts shall hold unlawful underlying contracts to be null and void.[2] Arbitration clauses embedded in unlawful agreements do not confer any power on an arbitrator.

In conflict with these state high court decisions are the Ninth Circuit's opinion in this case and opinions of the Fifth, Sixth, and Eleventh Circuits that arbitrators rather than courts should determine whether illegality renders an underlying agreement void *ab initio*.

A question of subject matter jurisdiction is also presented by this case: Whether a proceeding to review a zero-dollar arbitration award complies with the amount-in-controversy requirement for diversity jurisdiction under 28 U.S.C. § 1332. The Ninth Circuit's decision in this case, where Theis did not request remand for further arbitration proceedings, conflicts with positions taken in decisions of the Sixth and Eleventh Circuits that the amount of the award must satisfy the amount-in-controversy requirement.

Factual and Procedural Background: Respondent Brown & Bain (B&B) is a law firm that represented Theis' patent rights in several matters, including unsuccessful patent litigation in the United States District Court for the Northern District of California against major telephone companies and manufacturers.[3] To comply with an

---

[2] Decisions of the high courts of Iowa and Minnesota similarly recognize the role of courts to make such determinations.

[3] *See* ER 41 at 4-10, 44-55; ER 42 at 1-3; FER 96 at 32-36. Record citations are to excerpts of record (ER), including

arbitration clause in B&B's legal services agreement, Theis brought malpractice claims against B&B in an arbitration proceeding, which resulted in an award that gave nothing to Theis.[4]

The Ninth Circuit noted the arbitrator's comment that:

> Viewed as a whole, the litigation that is the subject of this arbitration was an almost unmitigated disaster both for [Theis] and for B&B.

App. at 5a. The arbitrator acknowledged that "B&B did make mistakes," but he repeatedly concluded that B&B's conduct of the patent litigation fell within the scope of professional discretion and "judgment" calls.[5]

---

supplemental (SER) and further (FER) excerpts, filed in the Ninth Circuit.

Adverse parties included Pacific Telesis Group (now part of SBC) and PacTel Cellular (known later as AirTouch Cellular and subsequently part of the Verizon Wireless joint venture). *See* ER 42 at 6-8; ER 41 at 4-10, 17-22, 44-55.

The litigation concerned inventions of Peter F. Theis, the inventor or co-inventor with respect to 22 U.S. patents in telecommunications and voice processing technologies that underlie widely used applications such as interactive voice response, voicemail, automated operators, automated directory assistance, speech recognition, and automated area code detection and dialing. *See* ER 40 at 6; *see also* U.S. Patent Nos. 4,439,635 and 6,870,927 (issued March 22, 2005).

[4] ER 7 at 17-26; ER 13 at 7, 25; ER 41 at 52-53.

[5] ER 13 at 12-25.

In the months following the arbitration, Theis discovered—among roughly 100,000 documents that had been produced by B&B during the arbitration proceeding—an internal B&B memorandum that, for the first time, revealed to Theis that B&B simultaneously (and knowingly) represented a telephone company adverse to Theis in the patent litigation—before and during B&B's purported representation of Theis.[6]

In the arbitration, Theis had raised an issue about a B&B conflicting *indirect relationship*—which paled in comparison to the later discovered B&B conflicting *direct representations*. The issue concerned the handling of any potential future claims against Pacific Telesis Group (an adverse party in the patent litigation) involving use of equipment manufactured by Unisys (a B&B client that was *not* a party to the litigation).[7]

During the arbitration, Theis discovered among B&B's documents that B&B represented PacTel Cellular Inc. of Arizona.[8] Its parent corporation, PacTel Cellular, was an adverse party in the patent litigation. Under California law, however, simultaneous representation of a corporate subsidiary does not constitute a conflict of interest as to an adverse parent—unless a single identity for conflicts

---

[6] ER 19 at 2-4; ER 41 at 21-22, 37 (456:21-23); ER 42 at 1-2 (¶ 2), 5-8, 23-24, 27, 29, 34-35, 49; SER 92 at 23.

[7] ER 12 at 19-21.

[8] ER 42 at 18-19. PacTel Cellular was aware of B&B's simultaneous representation of Theis and PacTel Cellular Inc. of Arizona. During the patent litigation, in-house counsel for PacTel Cellular counter-signed a letter from B&B discussing the simultaneous representation. *Id.* B&B made no such disclosure to Theis. ER 42 at 2.

purposes is established by factors such as integrated management or operations. *Morrison Knudsen Corp. v. Hancock, Rothert & Bunshoft, LLP*, 69 Cal. App. 4th 223, 250-252 (1999).

During arbitration depositions, two senior B&B partners (the managing partner and the first of the name partners) gave false and misleading testimony, indicating that PacTel Cellular Inc. of Arizona did not have joint management or other ties to PacTel Cellular sufficient to permit treatment as a single entity for conflict purposes. Neither mentioned the B&B internal memorandum, even though both were named recipients.[9]

Unaware of B&B's internal memorandum, Theis did not—and could not—assert a conflicting representation in violation of California law. It could only mention, when briefing the Unisys issue, that B&B had represented an entity related to an adverse party.[10]

Subsequent to the arbitration, Theis discovered the PacTel Cellular conflict when it found B&B's internal memorandum, disclosing that B&B knew that PacTel Cellular Inc. of Arizona had a single identity with PacTel Cellular for conflict purposes.[11] To quote B&B:

> Moreover, the companies, as set forth above, appear as a practical matter to be effectively functionally integrated on the business side —PTCAZ [PacTel Cellular Inc. of Arizona] does nothing operationally and is merely an

---

[9] ER 41 at 27-29, 32-34; 42 at 18-19, 23; SER 91 at 14.

[10] ER 12 at 21.

[11] ER 42 at 24, 29, 34-35.

> investment vehicle, while PacTel Cellular is an umbrella for all Pacific Telesis cellular operations. Even though disqualification for concurrent representation of a corporate parent and its wholly-owned subsidiary is based in California on a detailed factual inquiry and balancing, and not, as elsewhere, on a rigid "bright-line" rule, it appears Brown & Bain would have difficulty making the factual showing needed to avoid disqualification.[12]

Later, in its principal briefing to the Ninth Circuit, B&B acknowledged that it had indeed represented PacTel Cellular, the parent corporation.[13] B&B also admitted for the first time that it had represented Pacific Telesis, the first-tier parent corporation, which was also a named adverse party in the patent litigation.[14]

Within two weeks of discovering B&B's internal memorandum, Theis filed this diversity action in the district court,[15] charging B&B with this conflict of interest as well as the previously asserted malpractice claims, and seeking to vacate the arbitration award.[16]

---

[12] ER 42 at 34-35.

[13] Appellee's brief at 9.

[14] *Id.* at 19-24, 42, 54, & 24, n.5.

[15] Theis is an Illinois corporation. When the action was filed, B&B was a California and Arizona law firm.

[16] ER 1 at 1-7. Theis later moved—as a matter of law—for reimbursement, including $1,641,427.27 that it had paid directly to B&B for fees and costs. ER 40 at 5-6; ER 42 at 3, 74-131.

Subsequently, during litigation in the district court, B&B served interrogatory answers that disclosed a total of *five* different entities—*all simultaneously represented by B&B*—whose interests were known to be adverse to Theis' rights represented by B&B in the patent litigation.[17] These included AirTouch Communications (formerly known as PacTel Corp.). In its briefing to the Ninth Circuit, B&B ultimately conceded this was a single entity for conflict purposes with its parent corporation, Pacific Telesis, an adverse party in the patent litigation.[18] Having restricted it previously, the district court stopped further discovery.[19]

The legal services agreement expressly provided that it was governed by the laws of the State of California.[20]

---

[17] ER 96 at 8; ER 42 at 2, 6-8; ER 95 at 2, 10-21; ER 97 at 2; ER 109 at 1-3; *see* appellant's brief at 29-32.

[18] B&B's appellee's brief at 24, n.5. B&B not only misled Theis during the arbitration. Prior to its discovery responses, in its *prior* briefing to the Ninth Circuit during review of a venue determination, B&B made misleading statements concealing the extent of its representation of Pacific Telesis-related entities. In its *subsequent* appellee's brief, B&B referred to its "representation of Pacific Telesis" some 13 times. *Id.* at 19-24, 42, 54. But, in briefing the *prior* appeal to the Ninth Circuit, B&B stated that "Brown & Bain *never* represented Pacific Telesis, ..." 06/29/2000 appellee's brief at 17, n.2 (9th Cir. No. 00-15219)(excerpt at FER 130)(emphasis added); *see also* FER 44 at 12 (B&B's assertion that "Brown & Bain never represented Pacific Telesis Group or PacTel Cellular Corporation, ... *only* PacTel Cellular of Arizona")(emphasis added). B&B apparently had not expected that it would subsequently be compelled to reveal its representation of AirTouch Communications (formerly known as PacTel Corp.).

[19] ER 60 at 4; 69 at 4-6; 79; 87 at 2; 102 at 21; 103; 127 at 32.

[20] ER 41 at 53.

Under California law, however, B&B could not lawfully represent Theis. B&B's PacTel Cellular conflict (and other conflicts) violated California law, including the Rules of Professional Conduct, Rule 3-310(C)(3),[21] and California common law mandating a law firm's duty of loyalty.[22]

In both the district court and the Ninth Circuit, Theis primarily and repeatedly challenged the arbitration award based on B&B's conflicts of interest in violation of California law.[23] Under established California law, unlawful contracts are null and void. Where illegality affects the whole of an underlying transaction or agreement

---

[21] In violation of Rule 3-310(C), B&B never obtained Theis' informed written consent for any of these conflicts. In *Chambers v. Kay*, 29 Cal. 4th 142 (2002), the California Supreme Court held that where (as here) informed written consent is required by the rules, the client cannot give consent by anything less. *Id.* at 146, 155-156. *See also* U.S. District Court, N.D. Cal., Civil Local Rule 11-4 (incorporating California Rules of Professional Conduct).

[22] *Image Technical Service, Inc. v. Eastman Kodak Co.*, 136 F.3d 1354, 1358 (9th Cir. 1998); *People ex rel. Department of Corporations v. SpeeDee Oil Change Systems*, 20 Cal. 4th 1135, 1146-1147 (1999); *Anderson v. Eaton*, 211 Cal. 113, 116 (1930). *Accord Santa Clara County Counsel Attorneys Association v. Woodside*, 7 Cal. 4th 525, 548 (1994).

[23] *See, e.g.*, ER 40 at 1-2, 5-6; ER 47 at 1-4; ER 96 at 2-4; ER 102 at 7-9; appellant's brief at 20-47.

This accorded with the Ninth Circuit's prior direction to the district court that Theis' assertion of illegality be resolved on Theis' motion to vacate the award. *Theis Research, Inc. v. Brown & Bain*, 240 F.2d 795, 796 (9th Cir. 2001). The present Ninth Circuit opinion (App. at 14a) cannot be interpreted to suggest that this principal issue was not preserved for appeal.

containing an arbitration clause, the underlying agreement—including the arbitration clause—is void, and any resulting arbitration award is invalid.[24]

The district court (the same judge who had presided over the patent litigation) denied Theis' motions for partial summary judgment based on the conflicts.[25] During the arbitration proceeding, with reference to the Unisys matter, Theis had identified Unisys and Pacific Telesis Group in two interrogatory responses as "adverse interests" with which B&B had "direct *or indirect* client relationships."[26] Theis did not assert (or then know) that B&B had represented Pacific Telesis (or any related entity). Relying on this interrogatory reference to "Pacific Telesis Group,"[27] however, the district court concluded that Theis must have known during the arbitration proceeding of the conflict as to PacTel Cellular/PacTel Cellular Inc. of Arizona, even though there was no reference to either of these entities.[28] The district court then stated that by not presenting the

---

[24] *Loving & Evans v. Blick,* 33 Cal. 2d 603, 609-612 (1949) (vacating award; unlicensed contractor); *All Points Traders, Inc. v. Barrington Associates,* 211 Cal. App. 3d 723, 738 (1989) (vacating award; unlicensed broker). *Accord Moncharsh v. Heily & Blase,* 3 Cal. 4th 1, 32 (1992)(distinguishing unlawfulness of isolated provision in otherwise valid transaction).

[25] App. at 30a-42a.

[26] FER 7 at 29-30 (emphasis added); 12 at 25 (only citing Rule 3-310(*B*)(3)(relationships), not 3-310(*C*)(3)(representations)).

[27] "Pacific Telesis Group" is not an informal reference to a collection of related companies but the corporate name of the senior parent. *See* ER 42 at 24; ER 96 at 63.

[28] App. at 39a-40a.

conflict issue to the arbitrator, Theis waived any claim that the arbitration was a nullity.[29]

Nevertheless, California law holds in general that unlawfulness cannot be waived or ratified,[30] and in particular it permits an unlawfulness challenge to be raised for the first time in judicial proceedings to review an arbitration award.[31] Instead of following state law, the district court granted B&B's motion to confirm the arbitration award and thereafter granted B&B's motion for summary judgment, determining that all of Theis' claims—including those for conflicts of interest—were precluded by the arbitration award.[32]

---

[29] App. at 42a.

[30] *City Lincoln-Mercury Co. v. Lindsey*, 52 Cal. 2d 267, 274 (1959). *Accord International Assn. of Fire Fighters v. City of San Leandro*, 181 Cal. App. 3d 179, 182 (1986).

[31] *Loving & Evans v. Blick*, 33 Cal. 2d at 610-612; *Alternative Systems, Inc. v. Carey*, 67 Cal. App. 4th 1034, 1040 (1998); *Lindenstadt v. Staff Builders, Inc.*, 55 Cal. App. 4th 882, 892, 893, n.8 (1997); *South Bay Radiology Medical Assoc. v. W. M. Asher, Inc.*, 220 Cal. App. 3d 1074, 1080-1081 (1990). *Accord Moncharsh v. Heily & Blase*, 3 Cal. 4th at 32.

[32] App. at 31a, 38a-39a, 47a; ER 40 at 1, 5; ER 47 at 1-4; ER 94 at 1-4; ER 102 at 7-9. The district court used the federal transactional test, applied broadly to preclude claims a party "could have raised," instead of California claim preclusion doctrine. App. at 31a. Under California's incorporation of primary rights theory in preclusion doctrine—which rejects the transactional approach to claim preclusion—where (as here) a distinct, non-identical cause of action was not litigated in a prior proceeding, it is not precluded. *International Evangelical Church v. Church of the Soldiers etc.*, 54 F.3d 587, 590-591 (9th Cir. 1995).

The Ninth Circuit's opinion affirms the judgment entered by the district court. Without any support in the record, and without specifying the "conflicts" being referenced (e.g., the Unisys matter v. the simultaneous representation of PacTel Cellular/PacTel Cellular Inc. of Arizona or AirTouch Communications/Pacific Telesis), the Ninth Circuit held (App. at 13a) that:

> Theis submitted to the arbitrator the issue whether B&B's alleged conflicts of interest rendered the Theis-B&B legal services agreement void *ab initio*. The arbitrator rendered a decision on this issue adverse to Theis. The district court thus did not err when it determined that Theis was barred from relitigating the same issue as part of its federal court malpractice claims.

While the opinion vitiates the district court's waiver theory, the ultimate problem is the same: The Ninth

---

B&B's conflicts of interest resulting from its representations of PacTel Cellular/PacTel Cellular, Inc. of Arizona (discovered from the B&B internal memorandum found after the arbitration) and AirTouch Communications, GTE Mobile Communications, AT&T, and U.S. West Real Estate (disclosed in interrogatory responses while this case was pending) were distinct and separate wrongs against Theis. Therefore, under primary rights doctrine, Theis' damage claims based on each of these conflicts of interest constitutes a separate cause of action, which was not determined in the arbitration proceeding. *Branson v. Sun-Diamond Growers*, 24 Cal. App. 4th 327, 341-342 (1994).

Under California law, these conflict-of-interest claims are not precluded. The claims in arbitration did not involve federal questions, and B&B's legal services agreement (if given effect) provided that California law governs. ER 41 at 53.

Circuit's opinion cedes to arbitrators the judicial responsibility to determine whether an underlying agreement containing an arbitration clause is null and void *ab initio*.[33] It holds that arbitrators have the final say on conflicts of interest that undermine public confidence in the integrity of the judicial process, and that courts shall then do nothing to hold law firms engaging in such conduct to answer to their clients.

Yet by confirming an arbitration award rooted in an underlying agreement that was entered into unlawfully, both the Ninth Circuit and the district court have sealed the imprimatur of the federal courts on that illegality in derogation of state law.

REASONS FOR GRANTING THE PETITION

I. The Conflict among Several Circuits—over Whether Courts, as Opposed to Arbitrators, Shall Decide Challenges to an Underlying Agreement as Null and Void *ab Initio*—Concerns an Important Federal Question That Needs Resolution

Under the Federal Arbitration Act, the power of an arbitrator depends upon "[a] written provision in . . . a contract . . . to settle by arbitration a controversy thereafter arising out of such contract . . ., or an agreement in writing to submit to arbitration an existing controversy arising out

---

[33] The Ninth Circuit amended its opinion, simply deleting (a) its statement that Theis was required to submit the issue to the arbitrator and (b) its mis-citation of prior Ninth Circuit authority to the contrary. App. at 3a-4a. (The unamended version appears in bound volume 386 F.3d at 1185.) There is no substantive change, as the court still confirms the arbitrator's purported ruling without deciding the issue.

of such a contract, ..." 9 U.S.C. § 2. Such a provision or agreement "shall be valid, irrevocable, and enforceable, *save upon such grounds as exist at law or in equity* for the revocation of any contract." *Id.* (emphasis added).

Without such a contract or an agreement, there is no power to arbitrate.

In this case, B&B's legal services agreement was null and void *ab initio*. Because its PacTel Cellular conflict (and other conflicts) violated California law, including the Rules of Professional Conduct, Rule 3-310(C)(3),[34] and California common law mandating a law firm's duty of loyalty,[35] B&B could not lawfully represent Theis.

An agreement in violation of the Rules of Professional Conduct is unlawful and unenforceable. *Kallen v. Delug*, 157 Cal. App. 3d 940, 948-949, 951 (1984). "[A]n illegal contract is void . . .." *Id.* at 948, n.2. *See Chambers v. Kay*, 29 Cal. 4th at 158 (giving effect to agreement violating rules "would be untenable . . . ").

Under California law, private parties lack the capacity to enter into an unlawful contract. B&B lacked the capacity to enter into the legal services agreement. Similarly, Theis lacked any capacity to ratify the agreement.

---

[34] *See also* U.S. District Court, N.D. Cal., Civil Local Rule 11-4 (incorporating California rules).

[35] *Image Technical Service, Inc. v. Eastman Kodak Co.*, 136 F.3d 1354, 1358 (9th Cir. 1998); *People ex rel. Department of Corporations v. SpeeDee Oil Change Systems*, 20 Cal.4th 1135, 1146-1147 (1999); *Anderson v. Eaton*, 211 Cal. 113, 116 (1930).

> A party to an illegal contract cannot ratify it, cannot be estopped from relying on the illegality, and cannot waive his right to urge that defense.

City Lincoln-Mercury Co. v. Lindsey, 52 Cal. 2d at 274. *Accord International Assn. of Fire Fighters v. City of San Leandro*, 181 Cal. App. 3d at 182.

The purported legal services agreement—including the arbitration clause—was not merely voidable. It was null and void from the outset. That issue should be determined by a court. Further, the arbitration award should be vacated under 9 U.S.C. § 10(a)(4) because the arbitrator had no authority.

Applying the Federal Arbitration Act, the California Supreme Court determined in *Rosenthal v. Great Western Financial Securities Corp.*, 14 Cal. 4th 394 (1996), that: "If the entire contract is void *ab initio* . . ., the parties have not agreed to arbitrate any controversy; . . .." *Id.* at 416.

In the case before it, the court distinguished between fraud in the execution of the underlying agreement and fraud in the inducement. Because fraud in the execution would render the contract void, it is to be determined by a court. *Id.* at 417. Fraud in the inducement, however, would not negate the existence of the contract, but would only render it voidable, permitting the defrauded party the election of rescinding or enforcing the contract. *Id.* at 415.

Accordingly, the court distinguished the rule set forth by this Court in *Prima Paint Corp. v. Flood & Conklin Manufacturing Co.*, 388 U.S. 395 (1967), that an arbitrator decides a defense of fraud in the inducement of a contract

unless the fraud relates specifically to the arbitration clause itself and not to the contract.[36] *Id.* at 416.

Several circuits have also held that courts—rather than arbitrators—are to decide issues as to whether an underlying contract even existed or was null and void *ab initio.*[37]

In *Three Valleys Mun. Water Dist. v. E.F. Hutton*, 925 F.2d 1136, 1140 (9th Cir. 1991), the Ninth Circuit previously held that courts, not arbitrators, decide issues that determine whether an underlying contract (with an arbitration clause) existed in the first place. *Id.* at 1140-1141. *Three Valleys* distinguished the rule in *Prima Paint*, explaining that *Prima Paint* only concerned an issue of "voidability"—not a challenge to whether a valid contract existed at the outset.

> . . . *Prima Paint* applies to "voidable" contracts—those "where one party was an infant, or where the contract was induced by

---

[36] The *Prima Paint* rule is a practical necessity: Otherwise, any party claiming breach of a contract (that contains an arbitration clause) could claim fraud in the inducement and avoid arbitration by simply alleging that the breach manifests a false promise without an intent to perform.

[37] In *First Options of Chicago, Inc. v. Kaplan*, 514 U.S. 938, 944-945 (1995), this Court held regarding arbitrability that courts, rather than arbitrators, decide the scope of an arbitrator's authority under an arbitration clause—unless the parties have explicitly agreed to confer power on the arbitrator to decide arbitrability. Yet even the power of an arbitrator to decide the scope of a clause, when so empowered by such an explicit agreement, presupposes the existence of a valid underlying contract or agreement.

> fraud, mistake, or duress, or where breach of a warranty or other promise justifies the aggrieved party in putting an end to the contract." [Citation.] . . . . But, because an "arbitrator's jurisdiction is rooted in the agreement of the parties," [citations] a party who contests the making of a contract containing an arbitration provision cannot be compelled to arbitrate the threshold issue of the existence of an agreement to arbitrate. [Footnote.] *Only a court can make that decision.*

925 F.2d at 1140-1141 (emphasis added).

Other circuits have taken the *Three Valleys* approach. In *Sandvik AB v. Advent Int'l Corp.*, 220 F.3d 99 (3d Cir. 2000), the Third Circuit held:

> Mindful of the doctrine announced in *Prima Paint*, which did not consider a situation in which the existence of the underlying contract was at issue, we draw a distinction between contracts that are asserted to be "void" or non-existent, as is contended here, and those that are merely "voidable," as was the contract at issue in *Prima Paint*, for purposes of evaluating whether the making of an arbitration agreement is in dispute.

Id. at 107 (footnote omitted). Whether there is an agreement to arbitrate in turn depends on the validity of the underlying contract. *Id.* at 106.

Citing *Three Valleys* and *Sandvik*, in *Sphere Drake Ins. Ltd. v. Clarendon Nat'l Ins. Co.*, 263 F.3d 26, 31 (2d Cir. 2001), the Second Circuit also invoked "the distinction

between void and voidable contracts, a distinction already recognized in at least two other circuits."

> A void contract is one that produces no legal obligation. . . . [A] party alleging that a contract is void—and providing some evidence in support—is entitled to a trial on the contract's arbitrability.

Id. at 31.[38]

In *Spahr v. Secco*, 330 F.3d 1266, 1272, n.7 (10th Cir. 2003), the Tenth Circuit acknowledged that:

> It is true that many circuits have applied *Prima Paint* to voidable contracts—i.e., those where the contract was induced by fraud, mistake, or duress—but not to void contracts.

The court proceeded to distinguish *Prima Paint* even further, holding that even a question of voidability should be determined by the court—rather than the arbitrator—where the party objecting to arbitration asserted that the

---

[38] Applying the Federal Arbitration Act, the Supreme Court of Minnesota cited *Sphere Drake*, *Sandvik AB*, and *Three Valleys* in making the distinction that courts hear claims that a disputed contract is *void*, while claims that a contract is *voidable* must be arbitrated. *Onvoy, Inc. v. SHAL, LLC*, 669 N.W.2d 344, 353 (Minn. 2003).

> [P]arties may not be compelled to arbitrate claims if they have alleged that the contract at issue never legally existed.

Id. at 354.

underlying agreement with the arbitration clause was unenforceable based on a lack of mental capacity to enter into the agreement in the first place. *Id.* at 1272-1273.

In *I.S. Joseph Co. v. Michigan Sugar Co.*, 803 F.2d 396 (8th Cir. 1986), the Eighth Circuit stated:

> Case law supports our holding that the enforceability of an arbitration clause is a question for the court when one party denies the existence of a contract with the other.

Id. at 400 (directing district court to disregard arbitrators' validity holding).

In *Microchip Tech. Inc. v. U.S. Philips Corp.*, 367 F.3d 1350, 1356-1358 (Fed. Cir. 2004), the Federal Circuit determined that whether the plaintiff was a successor to a license agreement, which contained an arbitration clause, was a "gateway" issue to be determined by a court. To determine whether an arbitration agreement exists, the existence of the entire agreement was a "threshold question" for the court. *Id.* at 1358.

Still other circuits, however, have taken a contrary approach, rejecting the "void" versus "voidable" distinction. *Will-Drill Res., Inc. v. Samson Res. Co.*, 352 F.3d 211, 215, n.15 (5th Cir. 2003). *Will-Drill* held that a court must determine whether a contract contained sufficient signatures to be valid and therefore binding on even admitted signatories. The court attempted to distinguish Fifth Circuit precedent that an arbitrator determines whether illegality renders a contract void *ab initio*.

> We are forced here to an admittedly fine distinction. And we do not doubt that this distinction will occasionally be elusive.

Id. at 219.

In *Burden v. Check into Cash of Kentucky, LLC*, 267 F.3d 483 (6th Cir. 2001), the Sixth Circuit reversed and remanded a district court decision that relied on *Three Valleys* in holding that the court must determine whether illegality rendered an underlying agreement void *ab initio*.

Citing *Burden*, the Eleventh Circuit in *Bess v. Check Express*, 294 F.3d 1298, 1306 (11th Cir. 2002), held that an arbitrator should determine whether illegality rendered the substance of the underlying agreement void.

Burden was recently criticized in its circuit in a concurring opinion in *Match-E-Be-Nash-She-Wish Band of Pottawatomi Indians v. Kean-Argovitz Resorts*, 383 F.3d 512, 518-521 (6th Cir. 2004)(Cleland, D.J., sitting by designation, concurring.)

> Void and void *ab initio* agreements, as opposed to voidable agreements, are agreements that never existed. Confining void (or void *ab initio*) contracts to a narrow set of circumstances, as the court did in *Burden*, abrogates long-standing principles defining void contracts and holds as of no effect any legislature's decision to deem certain agreements void when they fail to comply with statutory requirements, ...
>
> The Federal Arbitration Act's policy favoring arbitration cannot compel an agreement to arbitrate where no contract

> exists. *A void contract is simply nonexistent and a provision of a contract that does not exist should not be separately enforceable.* This includes an arbitration clause.

Id. at 520-521 (emphasis added).

This important and recurring issue should be resolved.

II. The Conflict—over Whether, in a Diversity Case, State Law Can Render an Unlawful Underlying Agreement Void *ab Initio*, Nullifying the Arbitration Clause and Resulting Award—Concerns an Important Federal Question That Needs Resolution

Even though this case was brought as a diversity action, the Ninth Circuit refused to apply state law holding that unlawfulness pertaining to the whole of the underlying agreement renders the agreement—including the arbitration clause and the resulting arbitration award—null and void *ab inito*.

State-law contract rules govern the validity of arbitration agreements.

> When deciding whether the parties agreed to arbitrate a certain matter . . ., courts generally . . . should apply ordinary state-law principles that govern the formation of contracts.

First Options of Chicago, Inc. v. Kaplan, 514 U.S. at 944.

In *Prima Paint*, this Court noted that when enacting the Federal Arbitration Act, Congress intended "to make arbitration agreements as enforceable as other contracts, but not more so." 388 U.S. at 404, n.12.

> States may regulate contracts, including arbitration clauses, under general contract law principles and they may invalidate an arbitration clause "upon such grounds as exist at law or in equity for the revocation of *any* contract." 9 U.S.C. § 2 (emphasis added).

Allied-Bruce Terminix Cos. v. Dobson, 513 U.S. 265, 281 (1995). *Accord Doctor's Associates v. Casarotto*, 517 U.S. 681, 686-687 (1996).

California law meets the neutrality test because it holds generally that unlawful contracts are null and void. *See City Lincoln-Mercury Co. v. Lindsey*, 52 Cal. 2d at 274; *International Assn. of Fire Fighters v. City of San Leandro*, 181 Cal. App. 3d at 182; *Kallen v. Delug*, 157 Cal. App. 3d at 948, n.2. *See also Chambers v. Kay*, 29 Cal. 4th at 158 (giving effect to agreement violating the Rules of Professional Conduct "would be untenable . . . ").

In accordance with the general principle that unlawful contracts are void, California law holds that an arbitration award arising from an unlawful contract will not be enforced. *Loving & Evans v. Blick*, 33 Cal. 2d at 609-612 (vacating award; unlicensed contractor); *All Points Traders, Inc. v. Barrington Associates*, 211 Cal. App. 3d at 738 (vacating award; unlicensed broker).

In addition to the California Supreme Court, the high courts of at least three other states have determined that an arbitration clause is void and without effect when it is embedded in an illegal contract:

- Alabama: *Alabama Catalog Sales v. Gloria Harris M.Q., Inc.*, 794 So. 2d 312 (Ala. 2000)

- Florida: *Cardegna v. Buckeye Check Cashing, Inc.*, 894 So. 2d 860 (Fla. 2005)

- South Dakota: *Nature's 10 Jewelers v. Gunderson*, 2002 S.D. 80, 648 N.W.2d 804 (S.D. 2001).[39]

Accord Iowa Mgmt. & Consultants, Inc. v. Sac & Fox Tribe, 656 N.W.2d 167 (Iowa 2003). In *Iowa Mgmt. & Consultants*, the Iowa Supreme Court held that the lower court was to decide a challenge to the validity of the underlying agreement as invalid under federal tribal gaming law. *Id.* at 171-172. "[I]f the entire agreement is invalid under federal law, this would also invalidate the provision in the agreement for arbitration of disputes." *Id.*

Although the California Supreme Court did not decide *Loving & Evan v. Blick* under the Federal Arbitration Act, it relied on a state statute (Cal. Code Civ. Proc. § 1288(d)) that tracks the language of 9 U.S.C. § 10(a)(4):

> [T]he award must be vacated "where the arbitrators exceeded their powers, . . ." It seems clear that the power of the arbitrator to determine the rights of the parties is dependent upon the existence of a valid contract under which such rights might arise.

33 Cal.2d at 609-610.

The applicability of such state law is an important and recurring question under the Federal Arbitration Act. This

---

[39] *See also Onvoy, Inc. v. SHAL, LLC*, 669 N.W.2d at 354 (Minnesota Supreme Court), discussed *supra*, 20, n.38.

Court has determined that the Act applies to state court proceedings (*Southland Corp. v. Keating*, 465 U.S. 1, 12 (1984)), and that "the statute provides for 'the enforcement of arbitration agreements within the full reach of the Commerce Clause,' . . . " (*Citizens Bank v. Alafabco, Inc.*, 539 U.S. 52, 56 (2003)). According, the issue needs resolution by this Court as a question of federal law.

Contrary to the above-cited state high court decisions, the Fifth, Sixth, and Eleventh Circuits have given effect to arbitration clauses contained in underlying agreements challenged as unlawful, holding that that an arbitrator determines whether illegality renders a contract void *ab initio*. *Lawrence v. Comprehensive Business Services Co.*, 833 F.2d 1159, 1160-1162 (5th Cir. 1987); *Match-E-Be-Nash-She-Wish Band of Pottawatomi Indians v. Kean-Argovitz Resorts*, 383 F.3d 512, 515-518 (6th Cir. 2004); *Bess v. Check Express*, 294 F.3d 1298, 1306 (11th Cir. 2002).

Under California law, courts must decide if the underlying agreement was entered into unlawfully. The issue is not left to arbitrators.[40] Where, as in this case, the unlawfulness of the agreement as a whole is in issue, California authorities hold uniformly that unlawfulness may be raised at any time, including raising unlawfulness for the first time on a motion to vacate, or in opposition to a motion to confirm, the arbitration award. *Loving & Evans v. Blick*, 33 Cal. 2d at 610-612[41]; *Alternative Systems, Inc.*

---

[40] As applied to the particular facts of this case, a law firm's violation of conflict-of-interest rules should be public knowledge and should be adjudicated in a public forum. It should not be buried in a private arbitration.

[41] The Ninth Circuit's judgment conflicts directly with the California Supreme Court's holding that:

v. Carey, 67 Cal. App. 4th 1034, 1040 (1998); *Lindenstadt v. Staff Builders, Inc.*, 55 Cal. App. 4th 882, 892, 893, n.8 (1997); *South Bay Radiology Medical Assoc. v. W. M. Asher, Inc.*, 220 Cal. App. 3d 1074, 1080-1081 (1990). *Accord Moncharsh v. Heily & Blase*, 3 Cal. 4th at 32.

Whether such state law is to be given effect raises an important and recurring question under the Federal Arbitration Act that should be settled by this Court.

> [T]he rules which give finality to the arbitrator's determination of ordinary questions of fact or of law are inapplicable where the issue of illegality of the entire transaction is raised in a proceeding for the enforcement of the arbitrator's award. When so raised, the issue is one for judicial determination upon the evidence presented to the trial court, and any preliminary determination of legality by the arbitrator, whether in the nature of a determination of a pure question of law or a mixed question of fact and law, should not be held to be binding upon the trial court.

Id. at 609. The Ninth Circuit cited *Ficek v. Southern Pacific*, 338 F.2d 655 (9th Cir. 1964) for the proposition that a party may not submit an issue to arbitration and then challenge the arbitrator's authority. However, as one of the judges acknowledged at oral argument, *Ficek* involved a valid arbitration agreement, the only issue being whether the claim in question was within the scope of the original agreement (the *Ficek* court found it was).

Moreover, conduct cannot furnish by implication a substitute agreement to arbitrate. 9 U.S.C. § 2 (arbitration agreement must be "in writing"); Cal. Code Civ. Proc. § 1281 (same). Also, *Ficek* does not answer whether state law applies.

III. Conflict Concerning the Applicable Amount in Controversy for Diversity Jurisdiction to Review an Arbitration Award—Whether the Amount of the Award or the Amount in Issue in the Underlying Dispute—Should Be Resolved

This case involves review of a zero-dollar arbitration award. In the arbitration proceeding, Theis sought damages for malpractice far in excess of the $75,000 threshold for jurisdiction under 28 U.S.C. § 1332. Theis' complaint sought to have the zero-dollar award vacated, reasserted its malpractice claims, and asserted the newly discovered violation of California conflict-of-interest law.

The Ninth Circuit's opinion holds that the amount in controversy to review an arbitration award under 28 U.S.C. § 1332 is determined by the amount of the underlying dispute rather than the amount of the award. App. at 5a. This holding conflicts with opinions in two other circuits.

The Sixth Circuit in *Ford v. Hamilton Investments, Inc.*, 29 F.3d 255 (6th Cir. 1994), determined that the district court did not have diversity jurisdiction over a complaint to vacate an arbitration award against the plaintiff because the award was less that the § 1332 threshold, even though the plaintiff himself had claimed more in the underlying arbitration. *Id.* at 260. The court noted that the plaintiff did not ask the district court to order the arbitrators to re-open his claim against the defendant. *Id.*

In this case, neither Theis by its action nor B&B by its petition asked for a remand to the arbitrator.[42]

---

[42] In *Sirotzsky v. New York Stock Exchange*, 347 F.3d 985 (7th Cir. 2003), the Seventh Circuit stated that the amount sought in arbitration can be included in the amount in controversy

The Eleventh Circuit in *Baltin v. Alaron Trading Corp.*, 128 F.3d 1466 (11th Cir. 1997), determined that the district court did not have diversity jurisdiction to review an arbitration award because the award was less than the § 1332 threshold, even though the defendant had sought damages exceeding the § 1332 threshold in the underlying arbitration. *Id.* at 1468, 1472.

Unlike a case initiated by only a complaint for damages filed in a district court, where an arbitrator has issued an award and the case first comes to court for review, the award provides a new point of reference for determining the amount in controversy for purposes of § 1332.

The issue is whether § 1332 entitles every diverse plaintiff, who seeks to vacate a zero-dollar or minimal arbitration award, to have the award reviewed by a federal district court, followed by de novo review by a federal court of appeals.[43]

"*provided* the plaintiff is seeking to reopen the arbitration." *Id.* at 989 (emphasis added).

In *Bull HN Information Systems, Inc. v. Hutson*, 229 F.3d 321 (1st Cir. 2000), the First Circuit found there was jurisdiction to review a partial arbitration award, rendered in the first phase of a bifurcated arbitration proceeding, that was less than the $75,000 threshold. However, the amount remaining in controversy on the second phase exceeded $75,000, and the basis for challenging the first phase award would have effectively barred recovery in the second phase as well. The requested remand as to the first phase could have resulted in an award in excess of $75,000 for that first phase alone. *Id.* at 329.

[43] If the amount in controversy is, indeed, determined by the amount of the award, subject matter jurisdiction cannot be predicated simply on a party's reasserting in a complaint the very

Given the conflict created by the Ninth Circuit's opinion and the recurring nature of this issue, the question—whether the jurisdictional amount is determined by the arbitration award or the amount of the underlying dispute—should be resolved by this Court.

CONCLUSION

Based on the foregoing, Theis respectfully requests that the Court grant this petition.

Respectfully submitted,

PAUL R. JOHNSON
Counsel of Record
ROBERT D. EASSA
FILICE BROWN EASSA & MCLEOD LLP
1999 HARRISON STREET, 18TH FLOOR
OAKLAND, CA 94612
(510) 444-3131

May 2005

---

same claims made in the arbitration. To predicate supplemental jurisdiction on a related claim, the anchor claim, in its own right, "must have substance sufficient to confer subject matter jurisdiction on the court." *See United Mine Workers v. Gibbs*, 383 U.S. 715, 725 (1966)(federal question anchor).

As Theis briefed the Ninth Circuit, recognizing Theis' conflict-of-interest claims arising from B&B's simultaneous conflicting representations as new, independent claims that were not subsumed in the arbitration would be an independent basis for subject matter jurisdiction, but this would also compel a determination that Theis' conflict-of-interest claims are not barred by claim preclusion doctrine, requiring a reversal of the judgment of the district court.

APPENDIX

FOR PUBLICATION

UNITED STATE COURT OF APPEALS
FOR THE NINTH CIRCUIT

THEIS RESEARCH, INC., an Illinois corporation, *Plaintiff-Appellant*, v. BROWN & BAIN, a California and Arizona law firm, and such present and former Brown & Bain partners, associates, and other personnel responsible for the management and trial of all litigation involving Peter F. Theis and Theis Research, Inc., *Defendant-Appellee.*	No. 02-16839 D.C. No. CV-99-20645-RMW ORDER AMENDING OPINION AND DENYING REHEARING AND PETITION FOR REHEARING EN BANC AND AMENDED ORDER

Appeal from the United States District Court
for the Northern District of California
Ronald M. Whyte, District Judge, Presiding

Argued and Submitted
November 5, 2003—San Francisco, California

Filed October 20, 2004
Amended February 18, 2005

Before: David R. Thompson and Stephen S. Trott,

Circuit Judges, and Charles R. Weiner,*
Senior District Judge.

Opinion by Judge Thompson

COUNSEL

Paul R. Johnson, Oakland, California, for the plaintiff-appellant.

Paul Renne, San Francisco, California, for the defendant-appellee.

ORDER

The opinion in *Theis Research, Inc. v. Brown & Bain*, published at 386 F.3d 1180 (9th Cir. 2004), is amended as follows:

1. At page 1184, the first sentence of the last beginning paragraph on that page is deleted. The deleted sentence reads:

> Our conclusion that we measure the amount in controversy by the amount at stake in the underlying litigation is consistent not only with *American Guaranty* from this circuit, but with decisions from other circuits as well.

---

* Hon. Charles R. Weiner, Senior District Judge for Eastern Pennsylvania, sitting by designation.

The deleted sentence is replaced by the following sentence:

> Our decision to measure the amount in controversy in this case by the amount at stake in the underlying litigation is consistent not only with *American Guaranty* from this circuit, but with decisions from other circuits as well.

2. At page 1185, the first two sentences of the second paragraph under III MERITS are deleted. The deleted sentences read as follows:

> Theis was required to submit to the arbitrator the issue whether B&B's alleged conflicts of interest rendered the Theis - B&B legal services agreement void *ab initio*. *Three Valleys Mun. Water Dist. v. E.F. Hutton*, 925 F.2d 1136, 1140 (9th Cir. 1991) (federal court may consider a defense of fraud in the inducement of a contract only if the fraud relates specifically to the arbitration clause itself and not to the contract generally). The issue was actually submitted to the arbitrator, who rendered a decision adverse to Theis.

The two deleted sentences are replaced by the following two sentences:

> Theis submitted to the arbitrator the issue whether B&B's alleged conflicts of interest rendered the Theis-B&B legal services agreement void *ab initio*. The arbitrator rendered a decision on this issue adverse to Theis.

With the foregoing amendments, the panel has voted unanimously to deny the petition for rehearing. Judge Trott has also voted to deny the petition for rehearing en banc, and Judges Thompson and Weiner recommend denial of that petition.

The full court was advised of the petition for rehearing en banc and no judge has requested a vote on the petition for en banc rehearing. Fed. R. App. P. 35.

The petition for rehearing and the petition for rehearing en banc are DENIED. No further petitions for panel or en banc rehearing will be entertained.

OPINION

THOMPSON, Senior Circuit Judge:

This appeal presents the primary question whether, in a case in which a party seeks to vacate an arbitration award, the amount in controversy for diversity jurisdiction under 28 U.S.C. § 1332(a) is measured by the amount of the award or by the amount in dispute in the underlying litigation between the parties. The arbitration award which Theis Research, Inc. ("Theis") moved to vacate was for zero dollars. Contemporaneously with that motion, Theis filed a complaint that sought damages from Brown & Bain ("B&B") in excess of $200 mil-lion. The claims Theis alleged in this complaint substantially mirrored the claims it had asserted in the arbitration proceeding, which claims the arbitrator had rejected.

If we measure the amount in controversy for purposes of 28 U.S.C. § 1332(a) by the amount of the arbitration award, the district court lacked subject matter jurisdiction.

If we measure the amount in controversy by the amount in dispute in the underlying litigation, the district court had subject matter jurisdiction.

We conclude that the amount at stake in the underlying litigation, not the amount of the arbitration award, is the amount in controversy for purposes of diversity jurisdiction, and thus the district court had jurisdiction under 28 U.S.C. § 1332. The court denied Theis's motion to vacate the zero dollar arbitration award, granted B&B's motion to confirm the award, and granted summary judgment in favor of B&B and against Theis on the claims Theis asserted in its complaint. Theis appeals. We have jurisdiction under 28 U.S.C. § 1291, and we affirm.

I

FACTS AND PROCEEDINGS

B&B was Theis's attorney in patent litigation that turned out badly. Theis demanded arbitration of claims against B&B for legal malpractice, breach of fiduciary duty, fraud and breach of contract. The ensuing arbitration resulted in a zero dollar award to each party. In commenting on the litigation that spawned the arbitration, the arbitrator stated:

> Viewed as a whole, the litigation that is the subject of this arbitration was an almost unmitigated disaster both for [Theis] and for B&B. The hopes of [Theis] and its investors were dashed; years of work by Mr. Theis and others went unrequited; B&B got no return on millions of dollars of invested time, and had to chalk up a major loss on its results chart.

Dissatisfied with the arbitrator's decision, Theis filed in the United States District Court a "COMPLAINT FOR BREACH OF PROFESSIONAL AND FIDUCIARY DUTY, LEGAL MALPRACTICE, AND FRAUD: APPLICATION AND NOTICE OF MOTION TO VACATE ARBITRATION AWARD." Theis also demanded a jury trial. The claims Theis set forth in its complaint sought compensatory damages of $200 million, plus "exemplary and punitive damages."

After court proceedings which are not relevant to the issues before us, B&B filed a motion to confirm the arbitrator's award. Theis responded with a renewed motion to vacate the award and a motion for partial summary judgment. The district court denied Theis's motion to vacate and its motion for partial summary judgment. The court granted B&B's motion to confirm the award. Thereafter, the district court granted summary judgment in favor of B&B, which judgment rejected all of the claims Theis asserted in its complaint. This appeal followed.

On December 16, 2003, we filed a memorandum disposition affirming the district court's summary judgment in favor of B&B. At the time our memorandum disposition was filed, there did not appear to be any reason to question the existence of the district court's subject matter jurisdiction; the parties were diverse, and neither party suggested, nor did it occur to us, that the amount in controversy might not meet the $75,000 monetary threshold requirement of 28 U.S.C. § 1332(a).

The question of subject matter jurisdiction was called to our attention by *Luong v. Circuit City Stores, Inc.*, 256 F.3d 1188 (9th Cir. 2004) (*Luong I*), an opinion now withdrawn, which was filed after we had filed our memorandum disposition. In the *Luong I* opinion, a panel of this court,

with one member of the panel dissenting, held that the amount in controversy on a petition to vacate an arbitration award should be measured by the amount of the award rather than the amount of the claim in the underlying dispute. *Id.* at 1194. Applying this measure, *Luong I* determined that because no monetary damages had been awarded by the arbitrator, the amount in controversy requirement for diversity jurisdiction had not been met. *Id.* In view of what appeared to be similarities between *Luong I* and this case, we recalled our mandate and awaited finality of the *Luong I* decision.

The *Luong I* panel subsequently withdrew its opinion and replaced it with a new opinion, in which the panel unanimously held that the district court had subject matter jurisdiction predicated upon the existence of a federal question under 28 U.S.C. § 1331. *Luong v. Circuit City Stores, Inc.*, 368 F.3d 1109, 1112 (9th Cir. 2004) (*Luong II*). In the *Luong II* opinion, the panel did not address the question whether the amount in controversy in a proceeding to vacate an arbitration award should be determined by the amount of the award or by the amount at issue in the underlying dispute. This case presents that question. To resolve it, we ordered supplemental briefing limited to the issue whether the district court had subject matter jurisdiction. We now conclude that the district court had diversity jurisdiction pursuant to 28 U.S.C. § 1332. Our previously filed memorandum disposition is withdrawn, and we file this opinion affirming the district court's summary judgment in favor of B&B.

II

JURISDICTION

In *American Guaranty Co. v. Caldwell*, 72 F.2d 209 (9th Cir. 1934), we considered what was the appropriate

measure of the amount in controversy for purposes of diversity jurisdiction under 28 U.S.C. § 1332(a) in the context of proceedings in the district court initially to confirm, and then after re-arbitration, to vacate an arbitration award. In that case, the district court had acquired subject matter jurisdiction when American Guaranty removed to federal court the petitioner's application to confirm a $32,500 award. At that time the monetary threshold for diversity jurisdiction under § 1332(a) was $3,000. The district court vacated the $32,500 award because the arbitrator was biased, directed the parties to arbitrate their dispute anew, and retained jurisdiction of the case pending that arbitration. In the renewed arbitration proceedings, the plaintiff was shut out with a zero dollar arbitration award which it then sought to vacate by a motion filed in the pending district court case.

Eventually, the district court in *American Guaranty* vacated the zero dollar arbitration award, and American Guaranty appealed. On appeal, American Guaranty challenged the district court's subject matter jurisdiction, contending that the zero dollar award that resulted from the re-arbitration was insufficient to satisfy the then $3,000 threshold for diversity jurisdiction under 28 U.S.C. § 1332(a). The *American Guaranty* court rejected that argument, and held that the district court had not lost the subject matter jurisdiction it acquired when the case was first removed to federal court on what was then the petitioner's application to confirm the $32,500 award. The court stated "[i]t is the amount in controversy which determines jurisdiction, not the amount of the award." *Id.* at 211.

It is unclear whether in making this statement the *American Guaranty* court was referring to the zero dollar arbitration award the petitioner eventually sought to vacate,

or the $32,500 arbitration award the petitioner initially sought to confirm. However, the court's statement makes sense only if the court was referring to the zero dollar award — the one which had the potential of defeating subject matter jurisdiction. That the *American Guaranty* court measured the "amount in controversy" by the amount involved in the underlying dispute is made clear by the court's statement:

> In addition to the record showing this original award of $32,500, it further discloses that evidence had been offered showing [petitioner] had suffered damages in excess of $100,000, and in one of its answers [American Guaranty] claims an indebted-ness by way of offset of $5,525. *It is the amount in controversy which determines jurisdiction, not the amount of the award.*

Id. at 211 (emphasis added).

There is an important difference, however, between the present case and *American Guaranty*. In *American Guaranty*, the district court initially acquired jurisdiction by the filing of a motion to confirm the arbitration award of $32,500.

In the present case, the arbitration award was for zero dollars. Theis initially filed in the district court a motion to vacate that award, coupling that motion with a complaint that alleged substantially the same claims Theis had asserted in the arbitration. Theis's prayer for relief in its district court complaint was for $200 million plus "exemplary and punitive damages," which on the face of the complaint satisfied the $75,000 monetary threshold for diversity jurisdiction.

Theis argues, however, that we should ignore the claims it asserted in its district court complaint because those claims were "non-substantial" as evidenced by the district court's eventual dismissal of them as barred by *res judicata*. We reject this argument. To treat Theis's claims as non-substantial simply because they were eventually dismissed as being barred by *res judicata* would retroactively preclude jurisdiction in any action in which the affirmative defense of *res judicata* was asserted and successfully maintained. The question is not whether B&B was successful in its *res judicata* defense. The question is whether the amount of damages Theis claimed in its complaint was asserted in good faith; if so, that amount controls for purposes of diversity jurisdiction. *St. Paul Mercury Indem. Co. v. Red Cab Co.*, 303 U.S. 283, 288-89 (1938).

There is nothing on the face of Theis's complaint, nor in the record before us, to suggest that the claims Theis asserted in the district court were not asserted in a good faith belief in the validity of those claims, notwithstanding that it turned out Theis's good faith belief was misplaced. *See id.*; *see also Budget Rent-a-Car, Inc. v. Higashiguchi*, 109 F.3d 1471, 1473 (9th Cir. 1997) (dismissal for lack of jurisdiction not proper if claim exceeding jurisdictional amount is made in the com-plaint in good faith, even when later events reduce the amount recoverable).

[1] The question presented to us thus boils down to whether the $200 million Theis sought to recover by its complaint is the amount in controversy under 28 U.S.C. § 1332(a), or whether the amount in controversy must be measured by the zero dollar arbitration award Theis sought to vacate. We are satisfied that the amount in controversy is the amount Theis sought to recover by its complaint.

Decisions from other circuits support this conclusion, although the cases have turned upon whether the party seeking to vacate an arbitration award also sought to reopen the arbitration. *See Sirotzky v. New York Stock Exch.*, 347 F.3d 985, 989 (7th Cir. 2003) ("[T]he amount in controversy in a suit challenging an arbitration award includes the matter at stake in the arbitration, provided the plaintiff is seeking to reopen the arbitration."); *Baltin v. Alaron Trading Corp.*, 128 F.3d 1466, 1472 n.16 (11th Cir. 1997) ("[T]he [plaintiffs] did not request an award modification that would provide [them] with money. Instead, [they] sought merely to reduce or eliminate the arbitration award against them."); *Ford v. Hamilton Investments, Inc.*, 29 F.3d 255, 260 (6th Cir. 1994) ("In the arbitration proceedings [the plaintiff] claimed more than $50,000 against Hamilton Investments, but he never asked the district court to order that the arbitrators reopen his claim . . ."); *but see American Guaranty,* 72 F.2d at 211 (concluding that the amount in controversy in the arbitration itself determines jurisdiction; no apparent request for remand to arbitration); *Bull HN Info. Sys., Inc. v. Huston*, 229 F.3d 321, 329 (1st Cir. 2000) (reversing district court decision dismissing petition to vacate arbitration award based on fact that plaintiff did not seek remand to arbitration; instead, measuring "the amount in controversy by the amount at stake in the entire arbitration").

Although neither Theis nor B&B asked that the arbitration proceedings be reopened, Theis sought to obtain by its district court complaint substantially what it had sought to obtain in the arbitration. Theis simply chose to "reopen" its claims in the district court rather than in arbitration. The amount in controversy requirement of 28 U.S.C. § 1332(a) was satisfied.

[2] Our decision to measure the amount in controversy in this case by the amount at stake in the underlying litigation is consistent not only with *American Guaranty* from this circuit, but with decisions from other circuits as well. In the Eleventh Circuit's decision in *Baltin v. Alaron Trading Corp.*, 128 F.3d 1466 (11th Cir. 1997), the Baltins sought to undo an arbitration award under which they were required to pay Alaron Trading $36,284.69. *Id.* The court held that the then jurisdictional minimum of $50,000 was not met because "[t]he maxi-mum remedy sought by the Baltins was the vacatur of the arbitration award of $36,284.69." *Id.* Because neither the Baltins nor Alaron Trading sought additional damages, the amount in controversy was limited to the amount of the arbitration award. *See id.* & n.16.

Likewise, in *Ford v. Hamilton Investments, Inc.*, 29 F.3d 255 (6th Cir. 1994), the Sixth Circuit held that diversity jurisdiction was lacking because the amount in controversy did not exceed the $50,000 minimum. *Id.* at 260. As in *Baltin*, the party against whom a $30,524 arbitration award was entered simply sought to vacate that award, and neither party sought any additional damages. *Id.* Indeed, the Sixth Circuit was quite clear that had the losing party sought to challenge the arbitrator's denial of that party's counterclaims, the amount in controversy *would* have been met:

> In the arbitration proceedings Mr. Ford claimed more than $50,000 against Hamilton Investments, *but he never asked the district court to order that the arbitrators reopen his claim* against Hamilton Investments; all he sought from the district court was the vacation of an award that fell short of the jurisdictional

amount by almost $20,000.

Id. (emphasis added).

[3] We conclude that in the present case the monetary threshold of $75,000 for diversity jurisdiction under 28 U.S.C. § 1332(a) has been met. There is no dispute as to diversity of the parties. The district court, therefore, had subject matter jurisdiction pursuant to 28 U.S.C. § 1332.

III

MERITS

Theis also appeals the district court's summary judgment in favor of B&B by which the court rejected Theis's claims for breach of professional and fiduciary duty, legal malpractice, and fraud. We affirm the district court's summary judgment.

[4] Theis submitted to the arbitrator the issue whether B&B's alleged conflicts of interest rendered the Theis-B&B legal services agreement void *ab initio*. The arbitrator rendered a decision on this issue adverse to Theis. The district court thus did not err when it determined that Theis was barred from relitigating the same issue as part of its federal court malpractice claims. *Ficek v. S. Pac. Co.*, 338 F.2d 655, 657 (9th Cir. 1964) (claimant may not voluntarily submit his claim to arbitration, await the outcome, and if the decision is unfavorable, challenge the authority of the arbitrator to act).

Having submitted the claim to the arbitrator, Theis could seek vacatur of the arbitral result only if it was a manifest disregard of the law, *First Options of Chi., Inc. v. Kaplan*, 514 U.S. 938, 942 (1995) (citing *Wilko v. Swan*, 346 U.S. 427, 436-37 (1953)), an implausible interpretation

of the contract, *Employers Ins. of Wausau v. Nat'l Union Fire Ins. Co. of Pittsburgh*, 933 F.2d 1481 (9th Cir. 1991), the award was pro-cured by corruption, fraud, or undue means, 9 U.S.C. § 10, or the arbitrator exceeded his powers, *First Options*, 514 U.S. at 942. The only argument that fits within any of these categories which Theis made to the district court, and thus preserved for appeal, is its argument that the arbitrator's failure to disclose his involvement with B&B's malpractice carrier resulted in an award procured by corruption, fraud or undue means. This argument is wholly unsupported by the record. The arbitrator disclosed at the beginning of the hearing that he had arbitrated other legal malpractice claims involving the carrier, had recognized the carrier's representative's name on the attendance list, and had dealt with the representative in the context of prior arbitrations. He then asked the parties if there were any objections to his proceeding as arbitrator. All parties consented. By failing to object to the arbitrator proceeding as arbitrator, and continuing to participate in the hearing after the arbitrator's full disclosure, Theis waived any claim that the arbitrator's subsequent award should be vacated by reason of corruption, fraud or undue means predicated upon the arbitrator's involvement with B&B's malpractice carrier.

[5] Nor did the district court abuse its discretion when it refused to permit additional discovery. "We will only find that the district court abused its discretion if the movant diligently pursued its *previous* discovery opportunities, and if the movant can show how allowing *additional* discovery would have precluded summary judgment." *Qualls v. Blue Cross*, 22 F.3d 839, 844 (9th Cir. 1994) (emphasis in original). Theis failed to show how the additional discovery it sought would have precluded summary judgment. The district court did not err in denying further discovery.

No other issues raised in this appeal warrant further discussion.

AFFIRMED.

FOR PUBLICATION

UNITED STATE COURT OF APPEALS
FOR THE NINTH CIRCUIT

THEIS RESEARCH, INC., an Illinois corporation, *Plaintiff-Appellant*, v. BROWN & BAIN, a California and Arizona law firm, and such present and former Brown & Bain partners, associates, and other personnel responsible for the management and trial of all litigation involving Peter F. Theis and Theis Research, Inc., *Defendant-Appellee*.	No. 02-16839 D.C. No. CV-99-20645-RMW OPINION

Appeal from the United States District Court
for the Northern District of California
Ronald M. Whyte, District Judge, Presiding

Argued and Submitted
November 5, 2003—San Francisco, California

Filed October 20, 2004

Before: David R. Thompson and Stephen S. Trott,
Circuit Judges, and Charles R. Weiner,*
Senior District Judge.

---

* Hon. Charles R. Weiner, Senior District Judge for Eastern Pennsylvania, sitting by designation.

COUNSEL

Paul R. Johnson, Oakland, California, for the plaintiff-appellant.

Paul Renne, San Francisco, California, for the defendant-appellee.

OPINION

THOMPSON, Senior Circuit Judge:

This appeal presents the primary question whether, in a case in which a party seeks to vacate an arbitration award, the amount in controversy for diversity jurisdiction under 28 U.S.C. § 1332(a) is measured by the amount of the award or by the amount in dispute in the underlying litigation between the parties. The arbitration award which Theis Research, Inc. ("Theis") moved to vacate was for zero dollars. Contemporaneously with that motion, Theis filed a complaint that sought damages from Brown & Bain ("B&B") in excess of $200 mil-lion. The claims Theis alleged in this complaint substantia lly mirrored the claims it had asserted in the arbitration proceeding, which claims the arbitrator had rejected.

If we measure the amount in controversy for purposes of 28 U.S.C. § 1332(a) by the amount of the arbitration award, the district court lacked subject matter jurisdiction. If we measure the amount in controversy by the amount in dispute in the underlying litigation, the district court had subject matter jurisdiction.

We conclude that the amount at stake in the underlying litigation, not the amount of the arbitration award, is the amount in controversy for purposes of diversity jurisdiction, and thus the district court had jurisdiction under 28 U.S.C. § 1332. The court denied Theis's motion to vacate the zero dollar arbitration award, granted B&B's motion to confirm the award, and granted summary judgment in favor of B&B and against Theis on the claims Theis asserted in its complaint. Theis appeals. We have jurisdiction under 28 U.S.C. § 1291, and we affirm.

I

FACTS AND PROCEEDINGS

B&B was Theis's attorney in patent litigation that turned out badly. Theis demanded arbitration of claims against B&B for legal malpractice, breach of fiduciary duty, fraud and breach of contract. The ensuing arbitration resulted in a zero dollar award to each party. In commenting on the litigation that spawned the arbitration, the arbitrator stated:

> Viewed as a whole, the litigation that is the subject of this arbitration was an almost unmitigated disaster both for [Theis] and for B&B. The hopes of [Theis] and its investors were dashed; years of work by Mr. Theis and others went unrequited; B&B got no return on millions of dollars of invested time, and had to chalk up a major loss on its results chart.

Dissatisfied with the arbitrator's decision, Theis filed in the United States District Court a "COMPLAINT FOR BREACH OF PROFESSIONAL AND FIDUCIARY DUTY, LEGAL MALPRACTICE, AND FRAUD:

APPLICATION AND NOTICE OF MOTION TO VACATE ARBITRATION AWARD." Theis also demanded a jury trial. The claims Theis set forth in its complaint sought compensatory damages of $200 million, plus "exemplary and punitive damages."

After court proceedings which are not relevant to the issues before us, B&B filed a motion to confirm the arbitrator's award. Theis responded with a renewed motion to vacate the award and a motion for partial summary judgment. The district court denied Theis's motion to vacate and its motion for partial summary judgment. The court granted B&B's motion to confirm the award. Thereafter, the district court granted summary judgment in favor of B&B, which judgment rejected all of the claims Theis asserted in its complaint. This appeal followed.

On December 16, 2003, we filed a memorandum disposition affirming the district court's summary judgment in favor of B&B. At the time our memorandum disposition was filed, there did not appear to be any reason to question the existence of the district court's subject matter jurisdiction; the parties were diverse, and neither party suggested, nor did it occur to us, that the amount in controversy might not meet the $75,000 monetary threshold requirement of 28 U.S.C. § 1332(a).

The question of subject matter jurisdiction was called to our attention by *Luong v. Circuit City Stores, Inc.*, 256 F.3d 1188 (9th Cir. 2004) (*Luong I*), an opinion now withdrawn, which was filed after we had filed our memorandum disposition. In the *Luong I* opinion, a panel of this court, with one member of the panel dissenting, held that the amount in controversy on a petition to vacate an arbitration award should be measured by the amount of the award rather than the amount of the claim in the underlying

dispute. *Id.* at 1194. Applying this measure, *Luong I* determined that because no monetary damages had been awarded by the arbitrator, the amount in controversy requirement for diversity jurisdiction had not been met. *Id.* In view of what appeared to be similarities between *Luong I* and this case, we recalled our mandate and awaited finality of the *Luong I* decision.

The *Luong I* panel subsequently withdrew its opinion and replaced it with a new opinion, in which the panel unanimously held that the district court had subject matter jurisdiction predicated upon the existence of a federal question under 28 U.S.C. § 1331. *Luong v. Circuit City Stores, Inc.*, 368 F.3d 1109, 1112 (9th Cir. 2004) (*Luong II*). In the *Luong II* opinion, the panel did not address the question whether the amount in controversy in a proceeding to vacate an arbitration award should be determined by the amount of the award or by the amount at issue in the underlying dispute. This case presents that question. To resolve it, we ordered supplemental briefing limited to the issue whether the district court had subject matter jurisdiction. We now conclude that the district court had diversity jurisdiction pursuant to 28 U.S.C. § 1332. Our previously filed memorandum disposition is withdrawn, and we file this opinion affirming the district court's summary judgment in favor of B&B.

II

JURISDICTION

In *American Guaranty Co. v. Caldwell*, 72 F.2d 209 (9th Cir. 1934), we considered what was the appropriate measure of the amount in controversy for purposes of diversity jurisdiction under 28 U.S.C. § 1332(a) in the context of proceedings in the district court initially to confirm, and then after re-arbitration, to vacate an

arbitration award. In that case, the district court had acquired subject matter jurisdiction when American Guaranty removed to federal court the petitioner's application to confirm a $32,500 award. At that time the monetary threshold for diversity jurisdiction under § 1332(a) was $3,000. The district court vacated the $32,500 award because the arbitrator was biased, directed the parties to arbitrate their dispute anew, and retained jurisdiction of the case pending that arbitration. In the renewed arbitration proceedings, the plaintiff was shut out with a zero dollar arbitration award which it then sought to vacate by a motion filed in the pending district court case.

Eventually, the district court in *American Guaranty* vacated the zero dollar arbitration award, and American Guaranty appealed. On appeal, American Guaranty challenged the district court's subject matter jurisdiction, contending that the zero dollar award that resulted from the re-arbitration was insufficient to satisfy the then $3,000 threshold for diversity jurisdiction under 28 U.S.C. § 1332(a). The *American Guaranty* court rejected that argument, and held that the district court had not lost the subject matter jurisdiction it acquired when the case was first removed to federal court on what was then the petitioner's application to confirm the $32,500 award. The court stated "[i]t is the amount in controversy which determines jurisdiction, not the amount of the award." *Id.* at 211.

It is unclear whether in making this statement the *American Guaranty* court was referring to the zero dollar arbitration award the petitioner eventually sought to vacate, or the $32,500 arbitration award the petitioner initially sought to confirm. However, the court's statement makes sense only if the court was referring to the zero dollar award — the one which had the potential of defeating

subject matter jurisdiction. That the *American Guaranty* court measured the "amount in controversy" by the amount involved in the underlying dispute is made clear by the court's statement:

> In addition to the record showing this original award of $32,500, it further discloses that evidence had been offered showing [petitioner] had suffered damages in excess of $100,000, and in one of its answers [American Guaranty] claims an indebted-ness by way of offset of $5,525. *It is the amount in controversy which determines jurisdiction, not the amount of the award.*

Id. at 211 (emphasis added).

There is an important difference, however, between the present case and *American Guaranty*. In *American Guaranty*, the district court initially acquired jurisdiction by the filing of a motion to confirm the arbitration award of $32,500.

In the present case, the arbitration award was for zero dollars. Theis initially filed in the district court a motion to vacate that award, coupling that motion with a complaint that alleged substantially the same claims Theis had asserted in the arbitration. Theis's prayer for relief in its district court complaint was for $200 million plus "exemplary and punitive damages," which on the face of the complaint satisfied the $75,000 monetary threshold for diversity jurisdiction.

Theis argues, however, that we should ignore the claims it asserted in its district court complaint because those claims were "non-substantial" as evidenced by the district

court's eventual dismissal of them as barred by *res judicata*. We reject this argument. To treat Theis's claims as non-substantial simply because they were eventually dismissed as being barred by *res judicata* would retroactively preclude jurisdiction in any action in which the affirmative defense of *res judicata* was asserted and successfully maintained. The question is not whether B&B was successful in its *res judicata* defense. The question is whether the amount of damages Theis claimed in its complaint was asserted in good faith; if so, that amount controls for purposes of diversity jurisdiction. *St. Paul Mercury Indem. Co. v. Red Cab Co.*, 303 U.S. 283, 288-89 (1938).

There is nothing on the face of Theis's complaint, nor in the record before us, to suggest that the claims Theis asserted in the district court were not asserted in a good faith belief in the validity of those claims, notwithstanding that it turned out Theis's good faith belief was misplaced. *See id.*; *see also Budget Rent-a-Car, Inc. v. Higashiguchi*, 109 F.3d 1471, 1473 (9th Cir. 1997) (dismissal for lack of jurisdiction not proper if claim exceeding jurisdictional amount is made in the com-plaint in good faith, even when later events reduce the amount recoverable).

[1] The question presented to us thus boils down to whether the $200 million Theis sought to recover by its complaint is the amount in controversy under 28 U.S.C. § 1332(a), or whether the amount in controversy must be measured by the zero dollar arbitration award Theis sought to vacate. We are satisfied that the amount in controversy is the amount Theis sought to recover by its complaint.

Decisions from other circuits support this conclusion, although the cases have turned upon whether the party seeking to vacate an arbitration award also sought to reopen

the arbitration. *See Sirotzky v. New York Stock Exch.*, 347 F.3d 985, 989 (7th Cir. 2003) ("[T]he amount in controversy in a suit challenging an arbitration award includes the matter at stake in the arbitration, provided the plaintiff is seeking to reopen the arbitration."); *Baltin v. Alaron Trading Corp.*, 128 F.3d 1466, 1472 n.16 (11th Cir. 1997) ("[T]he [plaintiffs] did not request an award modification that would provide [them] with money. Instead, [they] sought merely to reduce or eliminate the arbitration award against them."); *Ford v. Hamilton Investments, Inc.*, 29 F.3d 255, 260 (6th Cir. 1994) ("In the arbitration proceedings [the plaintiff] claimed more than $50,000 against Hamilton Investments, but he never asked the district court to order that the arbitrators reopen his claim . . ."); *but see American Guaranty,* 72 F.2d at 211 (concluding that the amount in controversy in the arbitration itself determines jurisdiction; no apparent request for remand to arbitration); *Bull HN Info. Sys., Inc. v. Huston*, 229 F.3d 321, 329 (1st Cir. 2000) (reversing district court decision dismissing petition to vacate arbitration award based on fact that plaintiff did not seek remand to arbitration; instead, measuring "the amount in controversy by the amount at stake in the entire arbitration").

Although neither Theis nor B&B asked that the arbitration proceedings be reopened, Theis sought to obtain by its district court complaint substantially what it had sought to obtain in the arbitration. Theis simply chose to "reopen" its claims in the district court rather than in arbitration. The amount in controversy requirement of 28 U.S.C. § 1332(a) was satisfied.

[2] Our conclusion that we measure the amount in controversy in this case by the amount at stake in the underlying litigation is consistent not only with *American*

Guaranty from this circuit, but with decisions from other circuits as well. In the Eleventh Circuit's decision in *Baltin v. Alaron Trading Corp.*, 128 F.3d 1466 (11th Cir. 1997), the Baltins sought to undo an arbitration award under which they were required to pay Alaron Trading $36,284.69. *Id.* The court held that the then jurisdictional minimum of $50,000 was not met because "[t]he maximum remedy sought by the Baltins was the vacatur of the arbitration award of $36,284.69." *Id.* Because neither the Baltins nor Alaron Trading sought additional damages, the amount in controversy was limited to the amount of the arbitration award. *See id.* & n.16.

Likewise, in *Ford v. Hamilton Investments, Inc.*, 29 F.3d 255 (6th Cir. 1994), the Sixth Circuit held that diversity jurisdiction was lacking because the amount in controversy did not exceed the $50,000 minimum. *Id.* at 260. As in *Baltin*, the party against whom a $30,524 arbitration award was entered simply sought to vacate that award, and neither party sought any additional damages. *Id.* Indeed, the Sixth Circuit was quite clear that had the losing party sought to challenge the arbitrator's denial of that party's counterclaims, the amount in controversy *would* have been met:

> In the arbitration proceedings Mr. Ford claimed more than $50,000 against Hamilton Investments, *but he never asked the district court to order that the arbitrators reopen his claim* against Hamilton Investments; all he sought from the district court was the vacation of an award that fell short of the jurisdictional amount by almost $20,000.

Id. (emphasis added).

[3] We conclude that in the present case the monetary threshold of $75,000 for diversity jurisdiction under 28 U.S.C. § 1332(a) has been met. There is no dispute as to diversity of the parties. The district court, therefore, had subject matter jurisdiction pursuant to 28 U.S.C. § 1332.

III

MERITS

Theis also appeals the district court's summary judgment in favor of B&B by which the court rejected Theis's claims for breach of professional and fiduciary duty, legal malpractice, and fraud. We affirm the district court's summary judgment.

[4] Theis was required to submit to the arbitrator the issue whether B&B's alleged conflicts of interest rendered the Theis - B&B legal services agreement void *ab initio*. *Three Valleys Mun. Water Dist. v. E.F. Hutton*, 925 F.2d 1136, 1140 (9th Cir. 1991) (federal court may consider a defense of fraud in the inducement of a contract only if the fraud relates specifically to the arbitration clause itself and not to the contract generally). The issue was actually submitted to the arbitrator, who rendered a decision adverse to Theis. The district court thus did not err when it determined that Theis was barred from relitigating the same issue as part of its federal court malpractice claims. *Ficek v. S. Pac. Co.*, 338 F.2d 655, 657 (9th Cir. 1964) (claimant may not voluntarily submit his claim to arbitration, await the outcome, and if the decision is unfavorable, challenge the authority of the arbitrator to act).

Having submitted the claim to the arbitrator, Theis could seek vacatur of the arbitral result only if it was a manifest disregard of the law, *First Options of Chi., Inc. v. Kaplan*, 514 U.S. 938, 942 (1995) (citing *Wilko v. Swan*,

346 U.S. 427, 436-37 (1953)), an implausible interpretation of the contract, *Employers Ins. of Wausau v. Nat'l Union Fire Ins. Co. of Pittsburgh*, 933 F.2d 1481 (9th Cir. 1991), the award was pro-cured by corruption, fraud, or undue means, 9 U.S.C. § 10, or the arbitrator exceeded his powers, *First Options*, 514 U.S. at 942. The only argument that fits within any of these categories which Theis made to the district court, and thus preserved for appeal, is its argument that the arbitrator's failure to disclose his involvement with B&B's malpractice carrier resulted in an award procured by corruption, fraud or undue means. This argument is wholly unsupported by the record. The arbitrator disclosed at the beginning of the hearing that he had arbitrated other legal malpractice claims involving the carrier, had recognized the carrier's representative's name on the attendance list, and had dealt with the representative in the context of prior arbitrations. He then asked the parties if there were any objections to his proceeding as arbitrator. All parties consented. By failing to object to the arbitrator proceeding as arbitrator, and continuing to participate in the hearing after the arbitrator's full disclosure, Theis waived any claim that the arbitrator's subsequent award should be vacated by reason of corruption, fraud or undue means predicated upon the arbitrator's involvement with B&B's malpractice carrier.

[5] Nor did the district court abuse its discretion when it refused to permit additional discovery. "We will only find that the district court abused its discretion if the movant diligently pursued its *previous* discovery opportunities, and if the movant can show how allowing *additional* discovery would have precluded summary judgment." *Qualls v. Blue Cross*, 22 F.3d 839, 844 (9th Cir. 1994) (emphasis in original). Theis failed to show how the additional discovery it sought would have precluded summary judgment. The district court did not err in denying further discovery.

No other issues raised in this appeal warrant further discussion.

AFFIRMED.

FILED
AUG. 6, 2002
Richard W. Wieking
Clerk, U.S. District Court
Northern District of California

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

THEIS RESEARCH, INC.,	NO. C-99 20645 RMW
Plaintiff,	JUDGMENT
v.	
BROWN & BAIN,	
Defendant.	

IT IS HEREBY ORDERED, ADJUDGED AND DECREED that plaintiff Theis Research, Inc. take nothing by way of its complaint and that judgment be entered in favor of defendant Brown & Bain, a California and Arizona law firm, and such present and former Brown & Bain partners, associates, and other personnel responsible for the management and trial of all litigation involving Peter F. Theis and Theis Research, Inc.

DATED: 8/05/02

/s/ Ronald M. Whyte
RONALD M. WHYTE
United States District Judge

Entered 8/19/02

FILED
AUG. 6, 2002
Richard W. Wieking
Clerk, U.S. District Court
Northern District of California

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

THEIS RESEARCH, INC., Plaintiff, v. BROWN & BAIN, Defendant.	NO. C-99 20645 RMW ORDER GRANTING DEFENDANT'S MOTION FOR SUMMARY JUDGMENT AND DENYING PLAINTIFF'S MOTION FOR LEAVE TO FILE MOTION FOR RECONSIDERATION AND MOTION FOR PARTIAL SUMMARY JUDGMENT [Re: Docket Nos. 90 and 94]

On July 26, 2002, the court heard two motions filed by the parties: defendant's motion for summary judgment and plaintiff's motion for leave to file a motion for reconsideration and for partial summary judgment. Each party opposes the other party's motion. Having considered the papers submitted by the parties and having had the benefit of oral argument on the motions, for the reasons set forth below, the court grants defendant's motion and denies plaintiffs motion.

Plaintiff's motion for leave to file a motion for reconsideration and for partial summary judgment is denied. Plaintiff has shown no new actual conflicts of interest and has failed to demonstrate adequate grounds for the court to reconsider its prior order.

Defendant's motion for summary judgment is granted. Res judicata applies to preclude plaintiff from litigating the claims it seeks to litigate in this action. Int'l Assoc. of Machinists & Aerospace Workers v. Aeroiet-General Corp.. 263 F. Supp. 343, 346 (CD. Cat 1966). TRI is barred from relitigating any claim that it raised, or could have raised, in the arbitration. Clark v. Bear Stearns & Co.. Inc.. 966 F.2d 1318,1320 (9th Cir. 1992); Sutphin v. Speik. 15 Cal.2d 195, 202 (1940). Moreover, plaintiff raised the issue of Brown & Bain's alleged disabling and undisclosed conflict of interest in the arbitration proceedings, plaintiff had the opportunity to conduct discovery into the conflicts of interest and availed itself of that opportunity. Plaintiff had the opportunity to litigate the issue in arbitration and is now barred from litigating it in this action. Each of TRI's present claims falls within the scope of claims that were, or could have been, raised by TRI in the arbitration. Therefore, TRI is barred from asserting those claims in litigation and defendant is entitled to summary judgment.

ORDER

For the foregoing reasons, defendant Brown & Bain's motion for summary judgment is GRANTED and plaintiff Theis Research, Inc.'s motion for leave to file a motion for reconsideration and for partial summary judgment is DENIED.

DATED: 8/5/02

/s/ Ronald M. Whyte
RONALD M. WHYTE
United States District Judge

ORIGINAL
FILED
AUG. 28, 2001
Richard W. Wieking
Clerk, U.S. District Court
Northern District of California
San Jose

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

THEIS RESEARCH, INC., Plaintiff, v. BROWN & BAIN, Defendant.	NO. C-99 20645 RMW ORDER DENYING PLAINTIFF'S MOTIONS FOR PARTIAL SUMMARY JUDGMENT AND TO VACATE ARBITRATION AWARD AND GRANTING DEFENDANT'S MOTION TO CONFIRM ARBITRATION AWARD [Docket Nos. 1, 32, 35, 40]

The motions of plaintiff Theis Research, Inc. ("TRI" or "plaintiff1) for partial summary judgment and to vacate arbitration award and of defendant Brown & Bain ("Brown" or "defendant") to confirm arbitration award were heard on July 27,2001. The court has read the moving and responding papers and heard the oral argument of counsel. For the reasons set forth below, the court denies TRI's motions for partial summary judgment and vacation

of arbitration award and grants Brown's motion to confirm arbitration award.

I. BACKGROUND

TRI holds patents to numerous inventions made by Peter Theis in the fields of telecommunications and voice processing technologies. Mot. PSJ 6:11-14.[1] Octel, a supplier of equipment to various regional Bell operating companies, fearing infringement litigation, filed suit against TRI in this court on April 9, 1992, and sought a declaration of invalidity and non-infringement for certain of TRI's patents. Johnson Decl. Exh. 8.

About the same time as the Octel litigation was filed, PacTel Cellular Inc. of Arizona retained Brown to represent it in an action in Arizona state court. Theis Decl. Exh. 3 at 1. At that time, PacTel Cellular Inc. of Arizona was owned by PacTel Cellular Corporation, in turn a subsidiary of PacTel Corporation, which was wholly owned by Pacific Telesis Group. Id.

On April 15, 1992, PacTel in-house counsel advised Octel that PacTel Cellular "was subject to TRI claims for the use of Octel equipment." Johnson Decl. Exh. 10 at 2:14-19. PacTel demanded indemnification of PacTel Cellular by Octel, and promised that PacTel Cellular would assist Octel against TRI. Id. TRI filed a motion to dismiss or transfer this action on May 20,1992. Johnson Decl., Exh. 11 at 1. Both PacTel Cellular in-house and outside counsel filed

---

[1] The abbreviations used are as follows: motion of plaintiff Theis Research, Inc. for partial summary judgment ("Mot. PSJ"); Brown & Bain's opposition to motion of Theis Research, Inc. for partial summary judgment ("Opp. PSJ"); reply brief in support of motion of plaintiff Theis Research, Inc. for partial summary judgment ("Reply PSJ").

declarations in opposition to this motion.[2] Johnson Decl. Exh. 9-10. TRI's motion was denied on July 31,1992, resulting in TRI, an Illinois company, needing California counsel. Johnson Decl. Exh. 11 at 2.

Brown "pitched itself" to represent TRI. Johnson Decl. Opp. Dismiss Exh. 1 at 4-5. TRI gave Brown a list of companies against which it contemplated litigation on August 17,1992. Theis Decl. Exh. 1 at 2-4. The names "PacTel Cellular," "Pacific Telesis," and "Pacific Bell" were included on the list, but "PacTel Cellular Inc. of Arizona" was not. Id. Although TRI told Brown that it hoped in the future to bring claims against some of the entities named on the list, particularly noting that Pacific Telesis and several others were "involved directly in matters under discussion," at the time of Brown's retention, TRI was engaged in litigation only with Octel Corporation. 14; Johnson Decl. Exh. 15 at 1. The manner in which TRI's list was organized appears to indicate that TRI intended to specifically include those companies subsidiary to an enumerated regional Bell operating company, such as Pacific Telesis. Theis Decl. Exh. 1 at 2-4.

Brown ran an internal conflicts check on August 17, 1992, and found that PacTel Cellular Inc. of Arizona, was already a client of the firm. Theis Decl. Exh. 2 at 1-2. Brown's contact for PacTel Cellular Inc. of Arizona was Paul White, who was not only General Counsel of PacTel Corporation, but was also PacTel Cellular's in-house counsel. Theis Decl. Exh. 3 at 1; Exh. 5 at 5. Brown included an addendum with the retainer agreement (attachment 2) listing corporations against which Brown

---

[2] Plaintiffs request for judicial notice of the declarations of Robert Barr and Mary M. Hamaker in opposition to Theis Research's motion to dismiss or alternatively, to transfer, is granted.

could opt not to represent TRI. Johnson Decl. Exh. 15 at art. 2. Neither Pacific Telesis nor any of its subsidiaries were included in this list. Id. On October 30, 1992, TRI signed a retainer agreement with Brown for the Octel litigation. Johnson Decl. Exh. 15. This agreement contained a binding arbitration provision. Id.

Brown attorney Martin Lagod states in his declaration that in late 1992 he informed Peter Theis in a "conversation" that Brown would not represent TRI in any action against Pacific Telesis or PacTel Cellular Corporation. Lagod Decl. ¶¶ 3-4. Lagod states that Theis did not request that Brown withdraw from either its representation of TRI or PacTel Cellular Inc. of Arizona. Id. On June 16, 1993, a Brown internal memorandum analyzing this conflict situation was completed. Theis Decl. Exh. 5. The memorandum states that Brown contacted a legal ethicist at Boalt Hall School of Law on the matter, who advised Brown that its concurrent representation of TRI and PacTel Cellular Inc. of Arizona amounted to no more than "a very attenuated pure loyalty conflict" which should not disqualify Brown from representing either client. Id. at 8. Brown sought a signed waiver by PacTel on June 16, 1993 acknowledging the conflict, (subsequently signed by Paul White on June 21, 1993), but no such written waiver was ever presented to TRI. Theis Decl. Exh. 4; Theis Decl. ¶ 3. TRI asserts that Brown "never sought TRI's informed written consent, never provided TRI with written disclosure, and never even told TRI" of the conflict. Mot. PS J 9:1-4; Theis Decl. ¶¶ 3, 8.

On November 6, 1992, Brown filed a counterclaim on behalf of TRI in the Octel litigation, Alleging infringement of several of TRI's patents. Johnson Decl. Opp. Dismiss Exh. 1 at 11. Later, similar infringement claims were brought against other telecommunications companies,

including PacBell and certain of its suppliers and subsidiaries. Id at 11-12. A similar action against Bell Atlantic and many of its subsidiaries was brought by TRI in the Eastern District of Virginia in November 1992. Id. at 12. TRI stipulated in the Virginia proceeding that the findings in the California case would be binding on the parties to the Bell Atlantic litigation. Id. at 13. Many of the infringement and invalidity issues in the Octel suit were tried by jury in September 1994 with a result adverse to TRI. Other bifurcated issues were resolved by dispositive motions and judgment on those issues was entered on September 30,1998. The separate judgment on the jury verdict was affirmed on appeal (Octel Communications v. Theis Research Inc., 132 F.3d 51 (Fed. Cir. 1997)) as was the judgment on the issues resolved by summary judgment. Octel Communications v. Theis Research Inc., 217 F.3d 860 (Fed. Cir. 2000).

While the bifurcated issues were pending in this court and the appeal from the judgment on the jury verdict was pending before the Federal Circuit, this court in April 1995 granted Brown's motion to withdraw from its representation of TRI. In January 1996, TRI and Peter Theis served a demand for arbitration claiming legal malpractice, breach of fiduciary duty, fraud, and breach of contract against Brown, and the parties selected an arbitrator in November 1998. Upon completion of arbitration in April 1999 the arbitrator ruled against Theis and TRI on all of their claims. On July 12, 1999, TRI filed a complaint for legal malpractice and motion to vacate the arbitration award in this court. Brown moved to dismiss the complaint on August 16, 1999. Brown's motion to dismiss the complaint was granted, and TRI's motion to vacate the arbitration award was denied without prejudice on venue grounds. Judgment was entered on October 21, 1999; TRI moved to alter, amend, or vacate the judgment on November 2, 1999,

and the motion was denied on December 29, 1999. TRI appealed the grant of Brown's motion to dismiss and the dismissal without prejudice on venue grounds on January 19, 2000.

On February 18, 2000, Brown filed a petition for confirmation of the arbitration award in the U.S. District Court for the District of Columbia. On June 19, 2000, the District Court for the District of Columbia stayed the proceedings pending resolution of TRI's appeal by the Ninth Circuit.

On January 24, 2001, the Court of Appeals reversed this court's dismissal of TRI's motion to vacate based on the subsequently decided case of Cortez Byrd Chips. Inc. v. Bill Harbert Const. Co., 529 U.S. 193,195 (2000), which held that a motion to vacate or confirm an arbitration award could be brought in a district other than the one in which the arbitration was held. Theis Research Inc. v. Brown & Bain, 240 F.3d 795 (9th Cir. 2001). The Court of Appeals vacated as premature the dismissal of TRI's complaint and remanded the action to this court. It expressed no opinion as to the validity of TRI's complaint or its motion to vacate. Id. at 796.

On March 27, 2001, the District of Columbia district court transferred its case to this court. On April 26, 2001, Brown filed the present motion to confirm arbitration award. TRI filed the present motion for partial summary judgment and to vacate award on June 4, 2001.

II. ANALYSIS

A. TRI's Motion for Partial Summary Judgment

1. Illegality

TRI moves for partial summary judgment against Brown on the ground that the arbitration was void. TRI asserts that the retainer agreement containing the binding arbitration clause was unlawful due to an alleged conflict of interest on the part of Brown. Under both California and federal law, "arbitration agreements are valid, irrevocable, and enforceable, save upon such grounds as exist at law or in equity for the revocation of any contract." Armendariz v. Foundation Health Psychcare Services. Inc., 24 Cal. 4th 83, 98 (2000); see also 9 U.S.C. § 2; Cal. Code Civ. Proc. § 1281. Under California Law, a contract is unlawful if it is "[c]ontrary to an express provision of law," "[c]ontrary to the policy of express law, though not expressly prohibited," or "otherwise contrary to good morals." Cal. Civ. Code § 1667. The California Supreme Court has held that if "grounds exist to revoke the entire contract" and the contract contains an arbitration clause, "such grounds would also vitiate the arbitration agreement." Moncharsh v. Heily & Blase, 3 Cal. 4th 1, 29 (1992). Thus, "if an otherwise enforceable arbitration agreement is contained in an illegal contract, a party may avoid arbitration altogether." Id. at 29-30 (citing California State Council of Carpenters v. Superior Court, 11 Cal. App. 3d 144, 157 (1970).

Here, TRI contends that the retainer agreement is unlawful under California Civil Code section 1667 because Brown's failure to provide TRI with written disclosure of the alleged conflict of interest violated Rule 3-310 of the California State Bar Rules of Professional Conduct. Cal.

Civ. Code § 1667; Cal. R. Prof. Cond. Rule 3-310. TRI cites Loving & Evans v. Blick, 33 Cal. 2d 603 (1949), All Points Traders. Inc. v. Barrington Associates, 211 Cal. App. 3d 723 (1989), and Lindenstadt v. Staff Builders, Inc., 55 Cal. App. 4th 882 (1997), in support of its position that the illegality argument may be raised at any point during the proceedings. See Mot. PSJ 15:10-11, Reply PSJ 7:9-12.

However, the retainer agreement at issue here is distinguishable from the contracts at issue in the above-cited cases. Both All Points Traders and Lindenstadt involved contracts between an unlicensed real estate broker and another party, and Loving involved a contract between an unlicensed contractor and another party. California law specifically forbids unlicensed contractors and real estate brokers from bringing or maintaining any action in any court.[3] Thus, any contract made between an unlicensed real estate broker or contractor and another party cannot be enforceable, and is void. Cal. Bus. Prof. Code. §§ 703 l(a) and 10136(a); see Rest. 2d Contr. § 7, comment a. In contrast, the retainer agreement at issue here was not void. Brown may have had a duty to provide written disclosure to TRI of any conflict of interest. See Cal. R. Prof. Cond. Rule 3-310; Cal. Civ. Code § 1667. When TRI became aware that Brown had a conflict of interest that it feiled to disclose, TRI could have elected to seek release from the retainer agreement. TRI could also have waived the conflict. The contract was thus voidable, not void. See Rest. 2d Contr. § 7, comment b; Cal. R. Prof. Cond. Rule 3-310. Although TRI apparently claims that it was unaware of Brown's alleged conflict of interest until after the arbitration had ended, TRI clearly knew about it by

---

[3] Under Loving, the phrase "action in any court of this State" also applies to proceedings to confirm arbitration awards. Loving, 33 Cal. 2d at 611-13.

November 20,1998, four months before the arbitration, when it named Pacific Telesis Group as one of Brown's conflicts in response to Brown's interrogatory. Schaible Decl. Mot. Dismiss Exh. C at 2. TRI also identified several of the documents on which it now relies to show a conflict as exhibits to its revised February 26,1999 arbitration exhibit list. See Schaible Decl. Exh. A at 1. These include Brown's initial conflicts check listing PacTel Cellular Inc. of Arizona as a Brown client (Exhibit 107) and the waiver sent by Brown to PacTel counsel Paul White detailing the conflict situation with TRI (Exhibit 125). Schaible Decl. ¶ 3, Exh. A at 4-5. TRI even stated in its initial written submission in the arbitration: "[i]n the course of these efforts, B&B pursued, on TRI's behalf, claims against a related party to one of B&B's own clients. B&B sought the advice of a law professor as to the ethical issues raised (Ex. 125; Brown, pp. 49-51), but B&B never disclosed the matter to TRI or sought TRI's consent." Johnson Decl. Opp. Dismiss Exh. 2 at 4. Thus, while TRI apparently did not actively pursue this claim during the arbitration, the quoted passage indicates that TRI was aware of the conflict situation with PacTel Cellular Inc. of Arizona prior to the arbitration proceedings.

TRI's arbitration exhibits 107 and 125 clearly serve as written disclosure by Brown of the alleged conflict of interest, and the record shows that TRI was aware of their import prior to the beginning of the arbitration. Thus, TRI had ample opportunity before arbitration to seek to withdraw its election to arbitrate or present the conflict issue to the arbitrator or the court. TRI, however, did not do so and instead proceeded with the arbitration. Therefore, TRI waived any claim that it was not contractually obligated to arbitrate any disputes with Brown or that the arbitration was a nullity.

2. Fraud

Even if TRI's claim is that the retainer agreement was obtained by fraud, the same result is feached. When a contract containing an arbitration clause is challenged as being fraudulent, the type of fraud determines whether the court may hear the claim. When the claim is that fraud "induced the entering into of the arbitration clause itself, the matter must be resolved by the court rather than the arbitrator." Johnson v. Siegel, 84 Cal. App. 4th 1087, 1095 (2000) (citing Engalla v. Permanente Medical Group, Inc., 15 Cal. 4th 951,973 (1997Y): Three Valleys Municipal Water District v. E.F. Hutton & Co.. Inc., 925 F.2d 1136, 1139 (9th Cir. 1991) (citing Prima Paint Corp. v. Flood & Conklin Mfg. Co., 388 U.S. 395, 403 (1967)). Any other claim must be heard by the arbitrator. Johnson, 84 Cal. App. 4th at 1095. Further, a distinction is made between fraud in the execution (where the signer did not know what the true nature of the document was) and fraud in the inducement (where the signer understood the document but would not have signed had he or she known all of the facts). See Southwest Administrators. Inc. v. Rozay's Transfer, 791 F.2d 769, 774 (9th Cir. 1986). In the former case, the contract is void because the fraud goes toward the making of the contract itself, "induc[ing] a party to believe the nature of his act is something entirely different than it actually is." Id. In the latter case, "[f]raud in the inducement of the underlying contract... is not sufficient to defeat an arbitration clause," because the clause was knowingly entered into. Johnson, 84 Cal. App. 4th at 1094. If the claim is fraud by inducement, the arbitrator "is competent and empowered to decide issues" relating to it, even if the claim includes allegations of a "grand scheme of fraud, or fraud permeating the transaction." Id.; Rosenthal v. Great Western Financial Securities Corp., 14 Cal. 4th 394, 398 (1996).

TRI's implied assertion is that it would not have signed the retainer agreement had it been aware of Brown's alleged conflict of interest. TRI thus could only claim fraud by inducement, not fraud in the execution. See Southwest Administrators, 791 F.2d at 774. As such, the retainer agreement was not void *ab initio*, and the matter was properly arbitrated pursuant to the arbitration clause. Further, TRI proceeded with arbitration after it had been provided with documents showing the alleged conflict. TRI cannot legitimately claim at the time it arbitrated that its agreement to arbitrate was unlawful.

3. Summary Judgment

Summary judgment is properly granted when there are no genuine disputed issues of material fact and when, viewing the evidence most favorably to the non-moving party, the movant is clearly entitled to prevail as a matter of law. See Fed. R. Civ. P. 56(c); Celotex Corp. v. Catrett, 477 U.S. 317, 322-23 (1986). The burden of proof to show an absence of material factual dispute lies with the moving party. See Fairbank v. Wunderman Cato Johnson, 212 F.3d 528, 531 (9th Cir. 2000). Here, TRI has failed to meet its burden of showing that it had neither actual nor constructive knowledge of Brown's relationships prior to or during the arbitration proceedings, a necessary showing in order for TRI to prevail. In the absence of such a showing, TRI's claim of illegality is waived, and its motion for partial summary judgment fails.[4]

---

[4] An arbitration award has the same preclusive effect as a judgment of court under the rules of res judicata. See this court's order granting defendant's motion to dismiss complaint and dismissing plaintiff's motion to vacate

B. TRI's Motion to Vacate Arbitration Award and Brown's Motion to Confirm Arbitration Award

TRI argues that the arbitration award should be vacated because (1) Brown allegedly made ex parte submissions to the arbitrator; (2) the arbitrator failed to disclose his involvement with Brown's insurer to TRI; and (3) the arbitrator failed to disclose that another arbitrator in his office had been chief counsel for Bell Atlantic, a corporation which had been adverse to TRI. The court's role in reviewing an arbitration award under the Federal Arbitration Act is "extremely narrow." Employers Ins. of Wausau v. National Union Fire Ins. Co. of Pittsburgh, 933 F.2d 1481, 1485 (9th Cir. 1991) (citations omitted). The court "may not predicate reversal on the arbitration panel's erroneous findings of fact or conclusions of law." Id. Under federal law, a court may vacate an arbitration award only (a) where the award was procured by corruption, fraud, or undue means; (b) where there was evident partiality or corruption of the arbitrators; (c) where the arbitrators were guilty of misbehavior by which the rights of any party have been prejudiced; or (d) where the arbitrators exceeded their powers, or so imperfectly executed them that a mutual, final, and definite award was not made. See 9 U.S.C. § 10.[5]

---

without prejudice, filed October 21, 1999, at 2:23-3:15, 4:7-13.

[5] Under California law, essentially the same standard applies. California Code of Civil Procedure section 1286.2 sets forth the six grounds available to the court for vacation of an arbitration award, including: (a) involvement of fraud or corruption in the arbitration award, (b) arbitrator corruption, (c) arbitrator misconduct leading to prejudice against any party, (d) the arbitrator exceeded his or her powers and the award cannot be corrected without affecting tile merits of the decision upon the controversy submitted, (e) failure to postpone the arbitration

"The burden of showing partiality" rests on the party challenging the arbitration decision. Woods v. Saturn Distribution Corp., 78 F.3d 424,427 (9th Cir. 1996) (citation omitted). Furthermore, claims of impropriety or bias are waived unless a timely objection is made. "A party may not sit idle through an arbitration proceeding and then collaterally attack that procedure on grounds not raised before the arbitrators when the result turns out to be adverse." Wellman v. Writers Guild of America. West. Inc., 146 F.3d 666, 673 (9th Cir. 1998) (citing Marino v. Writers Guild of America, East, Inc., 992 F.2d 1480, 1484 (9th Cir. 1993)).

1. Ex Parte Submissions

TRI argues that the award should be vacated based on Brown's alleged ex parte submission of three letters to the arbitrator. However, the arbitrator stated on the record on the first day of arbitration that he had received three letters from Brown, and offered them to TRI's counsel to read. See Schaible Decl. Mot. Conf. Exh. F at 23:7-22. TRI apparently did not object to these submissions (one of which TRJ had in fact already received) either at that time, or subsequently in fie proceedings. Id. Further, TRI has failed to show how it was prejudiced by these ex parte communications. Because a party to an arbitration cannot collaterally attack the arbitration on grounds that were evident during the proceedings, see Wellman, 146 F.3d at 673, TRI is estopped from bringing this claim after the conclusion of the arbitration proceedings.

2. Insurer's Involvement

---

when. Circumstances so dictated, and (f) failure of an arbitrator to disqualify him or herself under section 1281.9. See Cal. Code Civ. Pro. § 1286.2.

TRI also contends that the award should be vacated because the arbitrator was allegedly given information regarding Brown's insurer, despite the fact that he was not allowed to consider insurance matters, and that because this insurer had previously been a party in matters before the arbitrator, there may have been some bias on the part of the arbitrator. Schaible Decl. Exh. F at 6:2-6. TRI asserts that the arbitrator failed to inform TRI of his ties to the insurer, and did not give a full accounting of his contacts with the insurer. In California, an arbitrator is obligated to disclose to the involved parties those business relationships that might create an impression of possible bias. Britz, Inc. v. Alfa-Laval Food & Dairy Co., 34 Cal. App. 4th 1085, 1103 (1995) (citations omitted). However, in order to disqualify an arbitrator, "parties must demonstrate more than a mere appearance of bias," because arbitrators are not required to be held to the same high standards of impartiality as used for judges. Employers Insurance, 933 F.2d at 1489; see also Toyota of Berkeley y. Automobile Salesmen's Union. Local 1095. United Food and Commercial Workers Union, 834 F.2d 751, 755-6 (9th Cir. 1987).

Here, the arbitrator fulfilled his obligation to disclose to the parties his connection to Brown's insurer. On the first day of the arbitration proceedings, the arbitrator stated on the record that he had previously mediated malpractice matters in which one or more of the parties had been insured by Brown's insurer and that a representative of the insurer had attended. Schaible Decl. Exh. F at 5:18-6:18. Although the arbitrator expressly asked the parties if they objected, TRI did not do so, either at that time or later in the proceedings. Id TRI cannot collaterally assert an objection which was not made during the actual proceedings. See Wellman, 146 F.3d at 673.

3. Conflict of Interest

Finally, TRI contends that one of the arbitrator's colleagues at JAMS/Endispute had been the head counsel for Bell Atlantic, a corporation previously adverse to TRI, and that the arbitrator failed to disclose that alleged conflict to the parties. See Theis Decl. Opp. Conf. Arb. Exh. 1 at 1.[6] In the Ninth Circuit, the arbitrator has a duty to investigate and disclose any conflicts of interest that he or she may have with the parties to the arbitration. See Schmitz v. Zilveti, III, 20 F.3d 1043, 1049 (9th Cir. 1994). If an arbitrator fails to disclose a conflict of interest, a "reasonable impression of bias" is treated, because the "integrity of the process by which arbitrators are chosen is at issue." Woods, 78 F.3d at 427. Discovery related to a conflict of interest is not permitted without presentation of clear evidence of impropriety. See Woods, 78 F.3d at 430 (citing Andros Compania Maritima v. Marc Rich & Co., 579 F.2d 691,702 (2nd Cir. 1978) (upholding a district court's refusal to allow discovery as "a classic example of a losing party seizing upon a pretext for invalidating the arbitration award")); Coast Plaza Doctors Hosp. v. Blue Cross of California, 83 Cal. App. 4th 677, 689 (2000) ("limited discovery rights are the hallmark of arbitration").

Here, there is no evidence of any conflict of interest. The colleague left the arbitrator's firm in November 1998, the same month that the arbitration hearings began, and no evidence has been presented to show that the arbitrator

---

[6] Although there is no evidence that TRI objected to the arbitrator based on a conflict of interest, a conflict of interest claim is not waived by failure to object unless the party was apprised of the conflict before the end of the proceedings. See HSMV Corp. v. ADI Ltd., 72 F. Supp. 2d 1122, 1131 (CD. Cal 1999). There is no evidence in the record of any such disclosure, though TRI does appear to indicate that it learned of Wright's employment prior to the end of the arbitration. See Opp. Theis Mot. Conf. 2:23-24.

otherwise had any connection to Bell Atlantic. Theis Decl. Opp. Conf. Arb. Exh. 3. The party challenging the arbitration decision on the basis of arbitrator bias or conflict bears the burden of proof. See Woods, 78 F.3d at 427. TRI had the burden to prove a conflict of interest, but has failed to provide sufficient evidence to meet this burden.

Since TRI has failed to carry its burden of establishing grounds to vacate the arbitration award, the award must be confirmed.

III. ORDER

For the reasons set forth above, the court denies plaintiffs motions for partial summary judgment and vacation of arbitration award and grants defendant's motion to confirm arbitration award.

DATED: 8/29/01

/s/ Ronald M. Whyte
RONALD M. WHYTE
United States District Judge

Supreme Court, U.S.
FILED
JUN 20 2005
OFFICE OF THE CLERK

No. 04-1566

In The Supreme Court of the United States

THEIS RESEARCH, INC.,

Petitioner,

v.

BROWN & BAIN and such Present and Former Brown & Bain Partners, Associates, and other Personnel Responsible for the Management and Trial of all Litigation Involving Peter F. Theis and Theis Research, Inc.,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Ninth Circuit

RESPONDENT'S BRIEF IN OPPOSITION

PAUL A. RENNE
Counsel of Record
CHARLES M. SCHAIBLE
COOLEY GODWARD LLP
One Maritime Plaza, 20th Floor
San Francisco, CA 94111
(415) 693-2000

Counsel for Respondent

COCKLE LAW BRIEF PRINTING CO. (800) 225-6964
OR CALL COLLECT (402) 342-2831

CORPORATE DISCLOSURE

On July 1, 2004, Brown & Bain P.A. changed its name to Perkins Coie Brown & Bain P.A. Perkins Coie Brown & Bain P.A. is an Arizona professional corporation and a partner of Perkins Coie LLP. It has no parent corporation, and no publicly-held corporation owns 10 percent or more of its stock.

TABLE OF CONTENTS

		Page
I.	STATEMENT OF THE CASE	1
II.	REASONS FOR DENYING THE WRIT	4
	A. The First And Second Questions Identified By TRI Were Not Decided By The Court Of Appeals	4
	B. Even If The Court Of Appeals Had Reached The First And Second Questions Identified By TRI, Its Decision Could Not Present Any Review-Worthy Conflict	6
	C. The Third Question Identified By TRI Was Not Decided, And The Decision Of The Court Of Appeals Does Not Conflict With That Of Any Other Court	6
III.	CONCLUSION	9

TABLE OF AUTHORITIES

Page

CASES

Alternative Systems, Inc. v. Carey, 67 Cal. App. 4th 1034 (1998) 6

Baltin v. Alaron Trading Corp., 128 F.3d 1466 (11th Cir. 1997) 9

Bull HN Information Systems, Inc. v. Hutson, 229 F.3d 321 (1st Cir. 2000) 9

City of Chicago v. Int'l College of Surgeons, 522 U.S. 156 (1997) 7

Ficek v. S. Pac. Co., 338 F.2d 655 (9th Cir. 1964) 3

Ford v. Hamilton Investments, Inc., 29 F.3d 255 (6th Cir. 1994) 8

Horton v. Liberty Mutual Ins. Co., 367 U.S. 348 (1961) 8

Lindenstadt v. Staff Builders, 55 Cal. App. 4th 882 (1997) 6

Loving & Evans v. Blick, 33 Cal. 2d 603 (1949) 6

Sirotzky v. New York Stock Exchange, 347 F.3d 985 (7th Cir. 2003) 9

South Bay Radiology Medical Associates v. Asher, 220 Cal. App. 3d 1074 (1997) 6

United Mine Workers of America v. Gibbs, 383 U.S. 715 (1966) 8

STATUTES

28 U.S.C. § 1332(a) 7

28 U.S.C. § 1367(a) 7

TABLE OF AUTHORITIES – Continued

Page

U.S. SUPREME COURT RULE

Sup. Ct. R. 10(a) 6

I. STATEMENT OF THE CASE

In October 1992, TRI retained Brown & Bain to represent it in patent litigation with Octel Corporation. *See* App. at 33a. In September 1994, a jury trial in the United States District Court for the Northern District of California resulted in a verdict adverse to TRI. *See id.* at 36a.

Blaming its litigation defeat on alleged mistakes by Brown & Bain, TRI invoked a provision in the parties' legal services agreement, under which the parties agreed to submit all disputes to binding arbitration. *See id.* Pursuant to that agreement, TRI served a demand for arbitration on Brown & Bain in January 1996. *See id.* In November 1998, the parties jointly selected an arbitrator. *See id.* Discovery followed, in the course of which Brown & Bain produced to TRI complete documentation of its representation of PacTel Cellular Inc. of Arizona, including its conflict checks, internal memoranda, and the conflict waiver executed by the general counsel of PacTel Cellular Corporation. *See id.* at 40a.

TRI did not attempt to withdraw from the arbitration, but instead submitted its conflicts claims to the arbitrator. After extensive briefing, an evidentiary hearing, and submission by the parties of proposed findings of fact and conclusions of law, the arbitrator filed a decision in April 1999, ruling against TRI on each and every one of the claims asserted in its demand for arbitration. *See id.* at 36a; ER 13 at 6. With specific regard to TRI's allegations of conflict of interest, the arbitrator ruled: "There was no credible evidence that B&B violated any duty it owed to TRI with regard to conflicts of interest." *See* ER 13 at 11.

Dissatisfied with the arbitrator's decision, TRI filed this lawsuit in July 1999. In a pleading captioned "Complaint for Breach of Professional and Fiduciary Duty, Legal Malpractice, and Fraud: Application and Notice of Motion to Vacate Arbitration Award," TRI sought compensatory damages of $200 million plus "exemplary and punitive damages." *See* App. at 6a. Among other things, TRI argued that the zero-dollar arbitration award should be disregarded and its malpractice claims should be retried because TRI was not aware of supposed conflicts of interest that would have voided the parties' legal services agreement and its arbitration clause. Brown & Bain countered by moving to confirm the arbitration award. In August 2001, the district court granted Brown & Bain's motion, finding that TRI knew the relevant facts regarding the alleged conflict of interest and waived any objection to arbitration by electing to proceed in front of the arbitrator:

> Although TRI apparently claims that it was unaware of Brown's alleged conflict of interest until after the arbitration had ended, TRI clearly knew about it by November 20, 1998, four months before the arbitration when it named Pacific Telesis Group as one of Brown's conflicts in response to Brown's interrogatory. . . .
>
> Thus, TRI had ample opportunity before arbitration to seek to withdraw its election to arbitrate or present the conflict issue to the arbitrator or the court. TRI, however, did not do so and instead proceeded with the arbitration. Therefore, TRI waived any claim that it was not contractually obligated to arbitrate any disputes with Brown or that the arbitration was a nullity.

Id. at 39a-40a.

In August 2002, the district court denied TRI's motions for reconsideration and summary judgment and granted Brown & Bain's cross-motion for summary judgment, again concluding that TRI could not re-raise in the district court issues that it chose to submit to arbitration:

> [P]laintiff raised the issue of Brown & Bain's alleged disabling and undisclosed conflict of interest in the arbitration proceedings . . . Therefore, TRI is barred from asserting those claims in litigation and defendant is entitled to summary judgment.

Id. at 31a.

The court of appeals affirmed in an opinion filed October 20, 2004, and amended February 18, 2005. *See id.* at 2a-15a. In affirming, the court of appeals relied on the district court's finding of fact that TRI voluntarily and knowingly submitted to the arbitrator the issue of Brown & Bain's alleged conflicts of interest:

> [TRI] submitted to the arbitrator the issue whether B&B's alleged conflicts of interest rendered the [TRI]-B&B legal services agreement void *ab initio*. The arbitrator rendered a decision on this issue adverse to [TRI]. The district court thus did not err when it determined that [TRI] was barred from relitigating the same issue as part of its federal court malpractice claims. *Ficek v. S. Pac. Co.*, 338 F.2d 655, 657 (9th Cir. 1964) (claimant may not voluntarily submit his claim to arbitration, await the outcome, and if the decision is unfavorable, challenge the authority of the arbitrator to act).

Id. at 13a.

Once again trying to challenge the jurisdiction of a forum in which it lost, TRI also contested federal jurisdiction over its complaint. The court of appeals rejected that argument as well, holding that federal jurisdiction was proper because the parties were diverse and the $200 million in damages sought by TRI's district court complaint easily satisfied the amount-in-controversy requirement. *See id.* at 10a.

II. REASONS FOR DENYING THE WRIT

TRI's petition for a writ of certiorari should be denied because it is premised on misstatements of fact and law. Not one of the questions identified by TRI as presented was actually decided by the court of appeals, and the decision of the court of appeals was both correct and not in conflict with the decision of any other court.

A. The First And Second Questions Identified By TRI Were Not Decided By The Court Of Appeals

TRI seeks certiorari on the ground that the decision of the court of appeals has created conflicts among the circuits on two questions: (i) "whether courts – as opposed to arbitrators – shall decide challenges to an underlying agreement with an arbitration clause on the ground that the agreement was void and never existed at the outset" and (ii) "whether, in a diversity case, state law can render an unlawful underlying agreement, including an arbitration clause and a resulting arbitration award, null and void *ab initio*." Pet at i. In fact, neither question was decided by either the district court or the court of appeals.

TRI contends, as it did in both the district court and the court of appeals, that the arbitrator's award should have been vacated because its agreement to arbitrate was rendered void *ab initio* by Brown & Bain's alleged conflicts of interest. *See* Pet. at 11-13. As it did in both the district court and the court of appeals, TRI premises this contention on the factual ground that it did not learn of Brown & Bain's alleged conflicts, and hence could not raise them, until after the arbitration had concluded. *See* Pet. at 7-9. This crucial factual predicate is inconsistent with the facts found by the district court and relied on by the court of appeals. The district court specifically found that TRI knew of the facts underlying the alleged conflict by November 1998, well before the arbitration took place, yet chose to proceed with the arbitration. App. at 39a-40a. The court of appeals affirmed that finding and agreed that TRI was not entitled to take another bite at the apple in federal court. App. at 13a. There is no reason or basis for this Court to revisit the lower courts' case-specific fact finding.

TRI simply ignores the fatal factual problem with its argument and mischaracterizes the holding of the court of appeals. The court of appeals never held, as TRI charges (Pet. at 3) that "even for admittedly meritorious claims of unlawful conflicts of interest, private arbitrators should have the final say in deciding the legality of underlying agreements, even when they undermine the judicial process." Rather than holding anything even resembling that proposition, the court of appeals simply affirmed that TRI waived any right to judicial resolution of the conflicts issue by knowingly and voluntarily submitting the issue to arbitration.

B. Even If The Court Of Appeals Had Reached The First And Second Questions Identified By TRI, Its Decision Could Not Present Any Review-Worthy Conflict

Because the court of appeals did not decide the questions TRI claims are presented, its decision could not have created any conflict among the circuits regarding them. But even if it had, no conflict worthy of this Court's review could have arisen for the simple reason that this diversity case was decided under the law of California. *See, e.g.*, Pet. at 11. The decision of the court of appeals applying California law could not meaningfully conflict with the decision of any other court of appeals applying federal law or the law of another state. The laws of the various states may permissibly differ one from another and, on these issues, from federal law. The decision of the court of appeals does not conflict with any decision of the California Supreme Court, much less any California Supreme Court decision applying *federal* law.[1] *See* Sup. Ct. R. 10(a).

C. The Third Question Identified By TRI Was Not Decided, And The Decision Of The Court Of Appeals Does Not Conflict With That Of Any Other Court

The decision of the court of appeals that the amount in controversy exceeded $75,000 and that the district court

---

[1] TRI's contention that "California authorities hold uniformly that unlawfulness may be raised at any time, including raising unlawfulness for the first time on a motion to vacate, or in opposition to a motion to confirm" (Pet. at 26) is simply wrong. *See, e.g., Loving & Evans v. Blick*, 33 Cal. 2d 603, 604-05 (1949); *South Bay Radiology Medical Associates v. Asher*, 220 Cal. App. 3d 1074, 1078 (1997); *Lindenstadt v. Staff Builders*, 55 Cal. App. 4th 882, 886 (1997); *Alternative Systems, Inc. v. Carey*, 67 Cal. App. 4th 1034, 1040 (1998).

accordingly had diversity jurisdiction does not conflict with that of any other court.

TRI's complaint was unusual in that it did not simply seek to vacate the zero-dollar arbitration award. Instead, the complaint expressly sought compensatory damages of $200 million. *See* App. at 6a. This critical fact was the basis of the court of appeals' decision, yet TRI's petition neglects to mention it. The court of appeals did *not* hold that the amount in controversy was the amount at stake in the underlying arbitration, but that the amount in controversy was the amount expressly demanded in TRI's *complaint in the district court*:

> The question presented to us thus boils down to whether the $200 million [TRI] sought to recover by its complaint is the amount in controversy under 28 U.S.C. § 1332(a), or whether the amount in controversy must be measured by the zero dollar arbitration award [TRI] sought to vacate. We are satisfied that the amount in controversy is the amount [TRI] sought to recover by its complaint.

App. at 10a. The court of appeals had no reason to decide and did not decide whether the district court would have had jurisdiction if TRI had simply moved to vacate the zero-dollar arbitration award.[2]

---

[2] Although TRI has not suggested, either in the court of appeals or in its present petition, that its motion to vacate should be treated as distinct from its complaint, were the Court to see fit to do so the district court would still have had supplemental jurisdiction of the motion to vacate pursuant to 28 U.S.C. § 1367(a), given that the claims asserted by TRI in that motion plainly derive from the same nucleus of operative fact as those asserted in its complaint. *See City of Chicago v. Int'l*

(Continued on following page)

The actual decision of the court of appeals does not conflict with any of the decisions cited by TRI. The only cited decision involving a federal complaint for damages is *Ford v. Hamilton Investments, Inc.*, 29 F.3d 255 (6th Cir. 1994), and the holding there is fully consistent with the holding here. Hamilton Investments had arbitrated a claim against Ford, a former employee, on which it was awarded $30,524. Like TRI, Ford then filed a complaint against Hamilton in the district court. Unlike TRI, however, Ford sought damages only in the amount of the award, which he alleged to have been entered in disregard of applicable law. The Sixth Circuit held that the Federal Arbitration Act itself confers no jurisdiction and no federal question was otherwise presented. As to diversity jurisdiction, the court of appeals cited *Horton v. Liberty Mutual Ins. Co.*, 367 U.S. 348 (1961), for the proposition that "[t]he general federal rule has long been to decide what the amount in controversy is from the complaint itself. . . . " *Ford*, 29 F.3d at 260, quoting *Horton*, 367 U.S. at 353. Because Ford's complaint sought only $30,524 in damages, less than the jurisdictional threshold, the amount-in-controversy requirement was not satisfied. That logic is fully consistent with the result here. The amount in controversy is the amount sought in the district court complaint. TRI's complaint sought $200 million, well over the jurisdictional threshold, so federal jurisdiction was proper.[3]

College of Surgeons, 522 U.S. 156, 165 (1997); *United Mine Workers of America v. Gibbs*, 383 U.S. 715, 725 (1966).

[3] Had TRI's complaint not explicitly sought damages over the jurisdictional limit, then and only then would the third issue in TRI's Petition have been raised. Even on that issue however, there is no circuit conflict. Courts of appeals consistently look to the amount at

(Continued on following page)

III. CONCLUSION

None of the questions identified by TRI as presented was actually decided by the court of appeals. The questions the court of appeals did decide were decided correctly, based on the unique facts of this case, and the holdings do not conflict with the decision of any other court. Accordingly, TRI's petition for a writ of certiorari should be denied.

Respectfully submitted,

PAUL A. RENNE
Counsel of Record
CHARLES M. SCHAIBLE
COOLEY GODWARD LLP
One Maritime Plaza, 20th Floor
San Francisco, CA 94111
(415) 693-2000

---

issue in the underlying disputes, rather than the amount of the arbitral award, to decide whether federal jurisdiction over the award exists. *See, e.g.*, *Bull HN Information Systems, Inc. v. Hutson*, 229 F.3d 321 (1st Cir. 2000); *Sirotzky v. New York Stock Exchange*, 347 F.3d 985 (7th Cir. 2003); *Baltin v. Alaron Trading Corp.*, 128 F.3d 1466 (11th Cir. 1997).

Supreme Court, U.S.
FILED
JUL 1 - 2005
OFFICE OF THE CLERK

No. 04-1566 (5)

In the Supreme Court of the United States

THEIS RESEARCH, INC.,

Petitioner,

v.

BROWN & BAIN
and such present and former Brown & Bain partners, associates, and other personnel responsible for the management and trial of all litigation involving Peter F. Theis and Theis Research, Inc.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

REPLY TO BRIEF IN OPPOSITION

PAUL R. JOHNSON
Counsel of Record
ROBERT D. EASSA
FILICE BROWN EASSA & MCLEOD LLP
1999 HARRISON STREET, 18TH FLOOR
OAKLAND, CA 94612
(510) 444-3131

Counsel for Petitioner

Becker Gallagher Legal Publishing, Inc. 800.890.5001

QUESTIONS PRESENTED

1. Whether courts—as opposed to arbitrators—shall decide challenges to an underlying agreement with an arbitration clause on the ground that the agreement was void and never existed at the outset, in contrast to agreements that are merely voidable.

2. Whether, in a diversity case, state law can render an unlawful underlying agreement, including an arbitration clause and a resulting arbitration award, null and void *ab initio*.

3. Whether, for diversity jurisdiction to review an arbitration award, the amount in controversy is determined by the amount of the award or the amount in issue in the underlying dispute.

Although petitioner requests grant and hold in the alternative, petitioner respectfully submits that plenary review of this case should be joined with consideration of the question presented in *Buckeye Check Cashing, Inc. v. Cardegna*, No. 04-1264, certiorari granted June 20, 2005:

> Whether the Florida Supreme Court erred by holding, consistent with the Alabama Supreme Court but in direct conflict with six federal courts of appeals, that the Federal Arbitration Act allows a party to avoid arbitration by claiming that the underlying contract containing an arbitration clause (but not the arbitration clause itself) is void for illegality.

Rule 29.6 Statement: As stated in the petition, there is no parent or publicly held company owning 10% or more of the stock of petitioner Theis Research, Inc.

TABLE OF CONTENTS

QUESTIONS PRESENTED i

INTRODUCTION 1

ANALYSIS 3

I. The Ninth Circuit Decided the First Two Questions 3

II. The Questions Presented Are Worthy of Review 7

A. The Grant of Certiorari in *Buckeye* Establishes That the First and Second Questions Are Worthy of Review 7

B. Plenary Review of This Case with *Buckeye* Is Essential to Provide a Complete Perspective of the Whole Issue Implicated by *Buckeye* 8

III. The Third Question Is Also Properly Presented 10

CONCLUSION 10

TABLE OF AUTHORITIES

Cases

All Points Traders, Inc. v. Barrington Associates
211 Cal. App. 3d 723 (1989) 9

Alternative Systems, Inc. v. Carey
67 Cal. App. 4th 1034 (1998) 5, 7

Buckeye Check Cashing, Inc., v. Cardegna,
No. 04-1264 (cert. granted June 20, 2005) ..... i, 1, 7-10

Cardegna v. Buckeye Check Cashing, Inc.
894 So. 2d 860 (Fla. 2005), cert. granted *sub nom.*
Buckeye Check Cashing, Inc., v. Cardegna,
No. 04-1264 7

Chambers v. Kay
29 Cal. 4th 142 (2002) 3

City Lincoln-Mercury Co. v. Lindsey
52 Cal. 2d 267 (1959) 3

Discover Bank v. Superior Court
No. S113725, slip op. at 27-29, __ Cal. 4th __,
2005 Cal. LEXIS 6866, *44-48,
2005 WL 1500866 (Cal.), *13-15
(Cal. June 27, 2005) 5

Green Tree Financial Corp. v. Bazzle
539 U.S. 444 (2003) 4-5

International Assn. of Fire Fighters v. City of San Leandro
181 Cal. App. 3d 179 (1986) 3

Lindenstadt v. Staff Builders, Inc.
55 Cal. App. 4th 882 (1997) 5-6

Loving & Evans v. Blick
33 Cal. 2d 603 (1949) 5-9

Moncharsh v. Heily & Blase
3 Cal. 4th 1 (1992) 9

Rosenthal v. Great Western Financial Securities Corp.
14 Cal. 4th 394 (1996) 8

South Bay Radiology Medical Assoc. v. W. M. Asher, Inc.
220 Cal. App. 3d 1074 (1990) 5-6

Statutes

9 U.S.C. § 2 5

9 U.S.C. § 4 1

9 U.S.C. § 10 8

28 U.S.C. § 1367 10

28 U.S.C. § 1652 10

Other Authority

California Rules of Professional Conduct
Rule 3-310 2-3

INTRODUCTION

Contrary to the claims of Brown & Bain (B&B) in its opposition, this case raises the questions presented in the petition. The issues were decided and are ripe for review.

While B&B argues that the first two questions are not worthy of review, the Court's recent grant of certiorari in *Buckeye Check Cashing, Inc., v. Cardegna*, No. 04-1264, establishes that they are. For reasons discussed below, this case should be reviewed with *Buckeye* to provide the Court a complete picture for analyzing and resolving the issue to be decided in *Buckeye*. *Infra*, at 8-9.

Petitioner Theis Research, Inc. (Theis) has consistently relied on state law holding that illegality concerning the whole of the underlying agreement—as in this case—nullifies any resulting arbitration award, and that courts will decide the issue regardless of whether it was raised to the arbitrator. *See* pet. at 13, 25-27; *infra*, at 6-7.

Theis asks this Court to grant review to decide questions of law, not to resolve issues of fact. B&B erroneously argues that the legal contentions advanced by Theis rest on a factual predicate as to when it started learning of B&B's simultaneous conflicting representations in violation of California law. It is true that the undisputed evidence establishes that Theis did not learn of any such conflict until after the arbitration.[1] Nevertheless, in both

---

[1] Theis demanded jury trial of facts under the FAA, 9 U.S.C. § 4. In dist. ct.: ER 1 at 7; 47 at 4; 60 at 4-5; appellant's br. at 48-49. Blurring the facts and breeding confusion, B&B seeks to turn to its advantage the multiplicity of its varied conflicting interests. The district court referenced the "conflict" (singular) issue raised in the arbitration, but this was the Unisys matter that only concerned Pacific Telesis Group indirectly as a Unisys customer.

the district court and the court of appeals, Theis asserted that factual contention *in addition*—and in the alternative—to the *legal* contentions presented by the petition. *See, e.g.*, appellant's br. at 34-42; appellant's reply br. at 14-24.

Precisely because the illegality of each of B&B's conflict-of-interest violations rendered the legal services agreement void *ab initio*, subsequent events are irrelevant. Nothing could revive an agreement that did not exist in the first place, regardless of when the illegality was discovered or first raised.[2]

ER 12 at 19-21. This did not involve the simultaneous representation of an adverse party or its equivalent (i.e., an integrated subsidiary). Theis noted to the arbitrator that it had learned of B&B's representation of a related party (PacTel Cellular Inc. of Arizona), *id.*, but Theis could not claim this was a conflict under California law. Theis had not yet discovered the internal memorandum disclosing that this was an integrated subsidiary of an adverse party (PacTel Cellular), thereby creating a conflict. ER 19 at 2-4; 42 at 23-24, 34-35; *see* pet. at 7-9.

B&B says it "produced" "complete documentation" of the PacTel Cellular/PacTel Cellular Inc. of Arizona conflict—including the internal memorandum—but B&B buried the memorandum among some 100,000 documents, placed almost 25,000 pages away from the letter referencing the representation of the subsidiary. ER 42 at 18-19 (##B094653-54), 23-48 (##B069817-42). Theis discovered the memorandum after the April 1999 arbitration award, and promptly brought this action—first raising B&B's conflict from its simultaneous representation of an adverse party equivalent. *See* Cal. R. Prof. Conduct 3-310(C). B&B first disclosed on May 9, 2002, its simultaneous representations of AirTouch Communications (fka PacTel Corp.) and three other telephone companies. ER 95 at 1-2; 96 at 8, 12.

[2] Though never given in this case, informed written consent—if given in the midst of a conflicted representation—might

Under both the district court's version (that the PacTel Cellular/PacTel Cellular Inc. of Arizona conflict and its invalidating effect were *not* raised to the arbitrator—and thus were waived, 34a, 38a-40a) and the court of appeals' version (that the conflicts and their invalidating effect *were* raised to the arbitrator—and could not thereafter be considered by a court, 13a), the issue was left for determination by an arbitrator and not considered on its merits by the court. That failure is before this Court as an error of law.

As discussed below, the petition also correctly presents for review the court of appeals' jurisdictional decision.

ANALYSIS

I. The Ninth Circuit Decided the First Two Questions

B&B concedes that Theis sought, in both the district court and the court of appeals, a judicial determination that the legal services agreement was void *ab initio*, and to have the arbitration award vacated as arising from an unlawful, void agreement under state law. Presented with these issues, the Ninth Circuit necessarily decided them adversely to Theis, regardless of whether or not the court detailed them in its opinion.

---

legitimize the representation going forward, but it does not change the fact that the representation up to that point was unlawful and therefore void. There is a distinction between (a) *ex ante* informed written consent—which Cal. R. Prof. Conduct 3-310(C) permits, and (b) *ex post facto* waiver of an unlawful contract—which California law does *not* permit. *City Lincoln-Mercury Co. v. Lindsey*, 52 Cal. 2d 267, 274 (1959); *International Assn. of Fire Fighters v. City of San Leandro*, 181 Cal. App. 3d 179, 182 (1986). *Accord Chambers v. Kay*, 29 Cal. 4th 142, 146, 155-156, 158 (2002)(recognition "untenable").

Contrary to B&B's claim (opp. br. at 5), Theis accurately recounted the position taken by the Ninth Circuit in this case—that even for admittedly meritorious claims of unlawful conflicts of interest, private arbitrators should have the final say in deciding the legality of underlying agreements, even when they undermine the judicial process. Pet. at 3 (n.1 omitted).[3]

The Ninth Circuit expressly held that Theis could not obtain a judicial determination on the merits of whether the legal services agreement was void *ab initio*, leaving untouched the purported decision of the arbitrator on this issue. App. at 13a.

B&B errs in suggesting that this Court cannot consider whether a court should now rule on the void-*ab-initio* issue. For example, in *Green Tree Financial Corp. v. Bazzle*, 539 U.S. 444 (2003), this Court considered whether a court or an arbitrator should decide the availability of a class action under an arbitration clause. The Court did not consider the question foreclosed because arbitration awards had already been rendered. The plurality opinion found that such an issue should be remanded to the arbitrator, but it raised a distinction that should be applied in this case:

> In certain limited circumstances, courts assume that the parties intended courts, not arbitrators, to decide a particular arbitration-related matter .... They include certain

---

[3] As noted in the petition, by the time it filed its appellee's brief in the most recent appeal to the Ninth Circuit, B&B finally admitted its conflict as to Pacific Telesis Group/AirTouch Communications (fka PacTel Corp.), as well as its conflict as to PacTel Cellular/PacTel Cellular Inc. of Arizona (also conceded in the internal memorandum). Pet. at 3 n.1, 8-9, 10 n.18.

> gateway matters, such as whether the parties have a valid arbitration agreement at all . . ..

Id. at 452. Even as to the issue in *Green Tree*, the dissent of the Chief Justice asserted that "this determination is one for the courts, not for the arbitrator, ..." *Id.* at 455. *See Discover Bank v. Superior Court*, No. S113725, slip op. at 27-29 (Cal. June 27, 2005)(courts decide enforceability).

The Ninth Circuit did not discuss state law because it did not apply it, thereby deciding *sub silentio* against Theis' contentions under state law.

B&B makes the extraordinary misstatement that "this diversity case was decided under the law of California." Opp. br. at 6. Even though it should have applied state law, the Ninth Circuit did not even purport to do so, disregarding principles of federalism embodied in both the Rules of Decision Act, 28 U.S.C. § 1652, and the Federal Arbitration Act, 9 U.S.C. § 2.

B&B misstates California law (opp. br. at 6 n.1) when it erroneously accuses Theis of the same thing:

> TRI[Theis]'s contention that "California authorities hold uniformly that unlawfulness may be raised at any time, including raising unlawfulness for the first time on a motion to vacate, or in opposition to a motion to confirm," (Pet. at 26) is simply wrong. *See, e.g., Loving & Evans v. Blick*, 33 Cal. 2d 603, 604-05 (1949); *South Bay Radiology Medical Assoc. v. W. M. Asher, Inc.*, 220 Cal. App. 3d 1074, 1078 (1997 [*sic*: 1990]); *Lindenstadt v. Staff Builders, Inc.*, 55 Cal. App. 4th 882, 886 (1997); *Alternative Systems, Inc. v. Carey*, 67 Cal. App. 4th 1034, 1040 (1998).

B&B is wrong. Taking B&B's cited cases seriatim:

- In *Loving & Evans*, the California Supreme Court explained that:

> [T]he rules which give finality to the arbitrator's determination of ordinary questions of fact or of law are inapplicable where the issue of illegality of the entire transaction is raised in a proceeding for the enforcement of the arbitrator's award.

33 Cal. 2d at 609. It made no difference that *both* sides had jointly submitted their dispute to arbitration "in line with" the underlying agreement. *Id.* at 604.

- Discussing *Loving & Evans*, the court in *South Bay Radiology* stated that:

> [T]he rationale the court employed makes it clear the illegality defense may be raised for the first time in opposition to a motion to confirm.

220 Cal. App. 3d at 1080-1081 (even though the assertion of illegality failed as a matter of substantive law, *id.* at 1079-1080, the court still held that the assertion of illegality could be raised at any time).

- The court in *Lindenstadt v. Staff Builders, Inc.*, 55 Cal. App. 4th at 892, stated that:

> [I]t did not matter that Staff Builders had submitted the illegality issue to the arbitrator or that the arbitrator had decided that issue.

The *Lindenstadt* court also noted, *id.* at 893 n.8:

> In determining the illegality question, the trial court should consider all of the admissible evidence submitted to it regardless of whether that evidence was before the arbitrator.

• Citing *Loving & Evans*, the court in *Alternative Systems* stated the same rule:

> The defense of illegality of the entire transaction can be raised at any stage of the proceeding, including opposition to a motion to confirm.

67 Cal. App. 4th at 1040.

The Ninth Circuit undeniably refused to apply California law to decide this case. That refusal is ripe for review.

II. The Questions Presented Are Worthy of Review

A. The Grant of Certiorari in *Buckeye* Establishes That the First and Second Questions Are Worthy of Review

In the petition, Theis cited the Florida Supreme Court's decision in *Cardegna v. Buckeye Check Cashing, Inc.*, 894 So. 2d 860 (Fla. 2005). That court is one of several state high courts in conflict with several circuits over the issue of whether an arbitration clause is void and without effect when it is embedded in an illegal contract. Pet. at 24-25. On June 20, 2005, this Court granted certiorari to review that case, *sub nom. Buckeye Check Cashing, Inc., v. Cardegna*, No. 04-1264. B&B's protestations notwithstanding (opp. br. at 6), the questions present an issue of federal law and are worthy of review.[4]

---

[4] The Ninth Circuit's refusal to apply state law in this case by itself presents a federal question, and the effect to be given such state law is an important and recurring question under the Federal Arbitration Act. The FAA has a broad reach (co-extensive with the Commerce Clause); the state arbitration statute cited by the California Supreme Court in *Loving & Evans*

B. Plenary Review of This Case with *Buckeye* Is Essential to Provide a Complete Perspective of the Whole Issue Implicated by *Buckeye*

This case presents a more complete picture about how to approach the issue.

The Court might well determine that *any* illegality in an underlying contract renders the entire contract—including an arbitration clause—void *ab initio*. Or the Court might defer to state law to determine whether the illegality has such an effect on the entire contract.

But the Court might instead determine that the answer turns on whether the unlawful provision is *severable* from an otherwise valid contract that contains the arbitration clause. If the illegality voids the entire contract, there is no surviving arbitration clause—and no power could have been conferred on an arbitrator. Conversely, illegality of a single provision, if severable, does not void the remaining lawful agreement. In that instance, the arbitration clause survives with the remainder of the contract; the parties' dispute is arbitrable; and even the illegality challenge to the single provision may be presented to the arbitrator—at least in the first instance.[5]

---

tracks the text of the FAA, 9 U.S.C. § 10(a)(4); and the California Supreme Court explicitly acknowledged the applicability of the FAA when deciding in *Rosenthal v. Great Western Financial Securities Corp.*, 14 Cal. 4th 394, 416 (1996) that: "If the entire contract is void *ab initio* . . ., the parties have not agreed to arbitrate any controversy; . . .." Pet. at 17, 25-26.

[5] Potentially, if the unlawfulness turns on the interpretation of a single provision of the contract, the arbitrator might construe that provision so as to avoid a conflict with state law.

The latter analysis is the approach taken by the California courts. In this case, the illegality goes to the very formation of the purported contract—rendering the entire agreement void *ab initio*. B&B violated California conflict-of-interest law by purportedly entering into the legal services agreement to represent Theis. B&B lacked lawful capacity to enter into such an agreement.

As discussed above, under the California approach, unlawfulness is decided by the court if the challenge applies to the agreement as a whole—such as in this case, where illegality concerns the formation of the purported contract. In such cases, it does not matter whether or not the unlawfulness was raised to the arbitrator. *Supra*, at 6-7.

In *Moncharsh v. Heily & Blase*, 3 Cal. 4th 1 (1992), the California Supreme Court distinguished the circumstance in the present case—where Theis challenges the entire legal services agreement because B&B entered into it in violation of California law:

> Both *Loving & Evans*, *supra*, 33 Cal. 2d 603, and *All Points Traders*, *supra*, 211 Cal. App. 3d 723 [(1989)], permitted judicial review of an arbitrator's ruling where a party claimed the entire contract or transaction was illegal. By contrast, Moncharsh challenges but a single provision of the overall employment contract.

3 Cal. 4th at 32. The court determined that the arbitration clause survived in an otherwise valid employment contract and that enforceability of the single provision should have been submitted to the arbitrator.

Whatever this Court ultimately determines to be the rule, the Court can best analyze, frame, and settle the issue by reviewing this case with *Buckeye*.

III. The Third Question Is Also Properly Presented

B&B misreads the Ninth Circuit's opinion. For the amount in controversy to review an arbitration award, the court framed its choices as the amount of the award or the amount disputed in the underlying litigation. App. at 4a-5a. It did not choose the amount of the award, conflicting with Sixth and Eleventh Circuit decisions. The amount in the "underlying litigation" concerned the arbitration claims, which the court treated interchangeably with damage claims in the complaint. App. at 4a. *But cf.* pet. at 30 n.43 (new conflict claims could anchor but then not precluded).

If the court had simply relied on the damage claims in the complaint (apart from arbitration claims), it would have treated these as a subject matter anchor and then invoked supplemental jurisdiction under 28 U.S.C. § 1367 for review of the arbitration award.[6] The court did not do so.

CONCLUSION

Theis requests that the petition be granted for plenary review. In the alternative, Theis requests grant and hold pending the Court's decision in *Buckeye*.

Respectfully submitted,

PAUL R. JOHNSON
Counsel of Record
ROBERT D. EASSA
FILICE BROWN EASSA & MCLEOD LLP
1999 HARRISON STREET, 18TH FLOOR
OAKLAND, CA 94612
(510) 444-3131

---

[6] Reasserting arbitration claims could then fabricate jurisdiction.

Supreme Court, U.S.
FILED
AUG 30 2005
OFFICE OF THE CLERK

(2)

No. 04-1566

In The Supreme Court of the United States

THEIS RESEARCH, INC.,

Petitioner,

v.

BROWN & BAIN and such Present and Former Brown & Bain Partners, Associates, and other Personnel Responsible for the Management and Trial of all Litigation Involving Peter F. Theis and Theis Research, Inc.,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Ninth Circuit

RESPONDENT'S SUPPLEMENTAL BRIEF

PAUL A. RENNE
Counsel of Record
CHARLES M. SCHAIBLE
COOLEY GODWARD LLP
101 California Street, 5th Floor
San Francisco, CA 94111-5800
(415) 693-2000

Counsel for Respondent

COCKLE LAW BRIEF PRINTING CO (800) 225-6964
OR CALL COLLECT (402) 342-2831

CORPORATE DISCLOSURE

On July 1, 2004, Brown & Bain P.A. changed its name to Perkins Coie Brown & Bain P.A. Perkins Coie Brown & Bain P.A. is an Arizona professional corporation and a partner of Perkins Coie LLP. It has no parent corporation, and no publicly-held corporation owns 10 percent or more of its stock.

TABLE OF CONTENTS

		Page
I.	Introduction	1
II.	Argument	1
III.	Conclusion	4

TABLE OF AUTHORITIES

Page

CASES

Buckeye Check Cashing, Inc. v. Cardegna, et al., No. 04-1264 1

Cardegna v. Buckeye Check Cashing, Inc., 894 So.2d 860 (2005) 1, 2

Ficek v. Southern Pacific Co., 228 F.2d 655 (9th Cir. 1964) 2

Nghiem v. NEC Elec., Inc., 25 F.3d 1437 (9th Cir. 1994) 3

Prima Paint Corp. v. Flood & Conklin Mfg. Co., 388 U.S. 395 (1967) 4

Sphere Drake Ins. Ltd. v. All Am. Ins. Co., 256 F.3d 587 (7th Cir. 2001) 2

Volt Information Sciences, Inc. v. Board of Trustees of the Leland Stanford Junior Univ., 489 U.S. 468 (1989) 2

Wolsey, Ltd. v. Foodmaker, Inc., 144 F.3d 1205 (9th Cir. 1998) 3

STATUTES

Supreme Court Rule 15(8) 1

I. Introduction

Brown & Bain submits this supplemental brief in response to TRI's suggestion, first made in reply, that its petition for writ of certiorari should be reviewed with *Buckeye Check Cashing, Inc. v. Cardegna, et al.*, No. 04-1264, "to provide the Court a complete picture for analyzing and resolving the issue to be decided in *Buckeye*." Reply at 1.[1] In fact, the issue in *Buckeye* is so utterly distinct from those presented here that whether the Court affirms or reverses in *Buckeye* can have no impact on its disposition of TRI's petition.[2]

II. Argument

In *Cardegna v. Buckeye Check Cashing, Inc.*, 894 So.2d 860 (2005), the Supreme Court of Florida held that:

> where a party sufficiently alleges that a contract is void for violation of Florida's usury laws, the Florida courts, and not an arbitrator, must first determine the contract's legality before a party may be required to submit to arbitration under a provision of the contract.

Id. at 865. The reason given by the court was that "if the underlying contract is held entirely void as a matter of

---

[1] This supplemental brief is submitted pursuant to Supreme Court Rule 15(8). Certiorari was granted in *Buckeye* on June 20, 2005, the date on which Brown & Bain's opposition brief was filed.

[2] The question presented in *Buckeye* is: "Whether the Florida Supreme Court erred by holding, consistent with the Alabama Supreme Court but in direct conflict with six federal courts of appeals, that the Federal Arbitration Act allows a party to avoid arbitration by claiming that the underlying contract containing an arbitration clause (but not the arbitration clause itself) is void for illegality."

law, all of its provisions, including the arbitration clause, would be nullified as well." *Id.* at 863. Therefore, "as arbitration depends on a valid contract an argument that the contract does not exist can't logically be resolved by the arbitrator." *Id.* at 863, *quoting Sphere Drake Ins. Ltd. v. All Am. Ins. Co.*, 256 F.3d 587, 591 (7th Cir. 2001). Not one of the issues identified by the Florida court is presented here.

First, unlike the respondent in *Buckeye,* TRI was not "*required* to submit to arbitration under a provision of the contract." *Buckeye*, 894 So.2d at 865 (emphasis added). On the contrary, TRI *voluntarily* submitted to arbitration with full knowledge of the conflict it later sought to allege in the district court. *See* App. at 13a; 31a; 39a-40a. Nor was the authority of the arbitrator to adjudicate TRI's claims premised on the parties' legal services agreement. On the contrary, by knowingly and voluntarily participating in arbitration, TRI conferred jurisdiction on the arbitrator regardless of whether the legal services agreement was void, voidable, or fully enforceable.

The jurisdiction of an arbitrator is derived from the consent of the parties, whether that consent is expressed in an arbitration agreement or by knowing participation in the arbitration itself. *See, e.g., Volt Information Sciences, Inc. v. Board of Trustees of the Leland Stanford Junior Univ.*, 489 U.S. 468, 479 (1989) (arbitration is a matter of consent; parties are free to structure their agreement as they see fit). In *Ficek v. Southern Pacific Co.*, 228 F.2d 655 (9th Cir. 1964), for example, the court of appeals rejected a collateral challenge to the validity of an arbitration award, premised on the arbitrator's lack of authority, on the ground that plenary authority was conveyed by the parties' participation in the arbitration:

> It is true that arbitration is a matter of contract, and that one is bound by an award only if he agreed to submit the dispute to arbitration. But an agreement to arbitrate a particular issue need not be express – it may be implied from the conduct of the parties.

Id. at 656; *see also Nghiem v. NEC Elec., Inc.*, 25 F.3d 1437 (9th Cir. 1994) ("Nghiem's voluntary initiation of arbitration can be interpreted as waiver of any objection he may have had over the authority of the arbitrator."). Here, as the court of appeals held, by voluntarily submitting Brown & Bain's alleged conflict to arbitration, TRI waived its right to relitigate that claim in the district court. *See* App. at 13a.

Second, the parties in *Buckeye* expressly agreed that their arbitration agreement was to be governed by the Federal Arbitration Act. *See Buckeye*, 894 So.2d at 861. Here, in contrast, the parties agreed to arbitrate pursuant to the procedural rules of the American Arbitration Association (*see* ER 7 at 18) and the substantive law of the State of California. *See* Pet. at 10. The validity of such agreements has long been recognized. *See Volt,* 489 U.S. at 479; *Wolsey, Ltd. v. Foodmaker, Inc.*, 144 F.3d 1205, 1209 (9th Cir. 1998) (parties are free to contract around the FAA by incorporating other rules into their agreements). Therefore, whatever the Court may decide as to the requirements of the Federal Arbitration Act in *Buckeye*, those requirements are without effect in cases, such as this, in which the parties have agreed to arbitrate under other rules.

Third, unlike the "entirely void" contract in *Buckeye*, the legal services agreement between Brown & Bain and

TRI was, at most, merely voidable. As the district court held:

> When TRI became aware that [Brown & Bain] had a conflict of interest that it failed to disclose, TRI could have elected to seek release from the retainer agreement. TRI could also have waived the conflict. The contract was thus voidable, not void. *See* Rest. 2d Contr. § 7, comment b; Cal. R. Prof. Cond. Rule 3-310.

App. at 39a. This distinction was crucial to the decision of the Florida Supreme Court in *Buckeye*, which distinguished *Prima Paint Corp. v. Flood & Conklin Mfg. Co.*, 388 U.S. 395 (1967) on the ground that the agreement at issue in *Prima Paint*, like that at issue here, was voidable rather than void.

III. Conclusion

TRI's petition for writ of certiorari should be denied for the reasons stated in Brown & Bain's opposition brief. Its belated suggestion that the Court hold that petition for review with *Buckeye* should be denied for the reasons stated above.

Respectfully submitted,

PAUL A. RENNE
Counsel of Record
CHARLES M. SCHAIBLE
COOLEY GODWARD LLP
101 California Street, 5th Floor
San Francisco, CA 94111-5800
(415) 693-2000

(4)

FILED
SEP 8 - 2005
OFFICE OF THE CLERK
SUPREME COURT, U.S.

No. 04-1566

In the Supreme Court of the United States

THEIS RESEARCH, INC.,

Petitioner,

v.

BROWN & BAIN
and such present and former Brown & Bain partners, associates, and other personnel responsible for the management and trial of all litigation involving Peter F. Theis and Theis Research, Inc.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

PETITIONER'S SUPPLEMENTAL BRIEF

PAUL R. JOHNSON
Counsel of Record
ROBERT D. EASSA
FILICE BROWN EASSA & MCLEOD LLP
1999 HARRISON STREET, 18TH FLOOR
OAKLAND, CA 94612
(510) 444-3131

Counsel for Petitioner

Becker Gallagher Legal Publishing, Inc. 800.890.5001

QUESTIONS PRESENTED

1. Whether courts—as opposed to arbitrators—shall decide challenges to an underlying agreement with an arbitration clause on the ground that the agreement was void and never existed at the outset, in contrast to agreements that are merely voidable.

2. Whether, in a diversity case, state law can render an unlawful underlying agreement, including an arbitration clause and a resulting arbitration award, null and void *ab initio*.

3. Whether, for diversity jurisdiction to review an arbitration award, the amount in controversy is determined by the amount of the award or the amount in issue in the underlying dispute.

Rule 29.6 Statement: As stated in the petition, there is no parent or publicly held company owning 10% or more of the stock of petitioner Theis Research, Inc.

TABLE OF CONTENTS

QUESTIONS PRESENTED i

INTRODUCTION 1

ARGUMENT 2

CONCLUSION 10

TABLE OF AUTHORITIES

Cases

Buckeye Check Cashing, Inc., v. Cardegna
No. 04-1264 (cert. granted June 20, 2005)..... 1-2, 6, 10

All Points Traders, Inc. v. Barrington Associates
211 Cal. App. 3d 723 (1989)..... 8

Allis-Chalmers Corp. v. Lueck
471 U.S. 202 (1985)..... 6

Chambers v. Kay
29 Cal. 4th 142 (2002)..... 8-9

Citizens Bank v. Alafabco, Inc.
539 U.S. 52, 56 (2003)..... 7

City Lincoln-Mercury Co. v. Lindsey
52 Cal. 2d 267 (1959)..... 10

Ficek v. Southern Pacific
338 F.2d 655 (9th Cir. 1964)..... 5

First Options of Chicago, Inc. v. Kaplan
514 U.S. 938 (1995)..... 6

Fortune, Alsweet & Eldridge, Inc. v. Daniel
724 F.2d 1355 (9th Cir. 1983)..... 5

Hotels Nevada, LLC v. Bridge Banc, LLC
130 Cal. App. 4th 1431 (2005)..... 7

International Assn. of Fire Fighters v. City of San Leandro
181 Cal. App. 3d 179 (1986)..... 10

Kallen v. Delug
157 Cal. App. 3d 940 (1984) 8

Loving & Evans v. Blick
33 Cal. 2d 603 (1949) 8

Nghiem v. NEC Electronic, Inc.
25 F.3d 1437 (9th Cir. 1994) 5

Piggly Wiggly Operators' Warehouse, Inc. v. Piggly Wiggly etc. Truck Drivers Union, Local No. 1,
611 F.2d 580 (5th Cir. 1980) 5

Rosenthal v. Great Western Financial Securities Corp.
14 Cal. 4th 394 (1996) 6

Teamsters Local Union No. 764 v. J.H. Merritt and Co.
770 F.2d 40 (3d Cir. 1985) 5

Textile Workers Union of America v. Lincoln Mills
353 U.S. 448 (1957) 6

Statutes

9 U.S.C. § 2 4

9 U.S.C. § 9 7

28 U.S.C. § 1652 6

29 U.S.C. § 185 6

California Code of Civil Procedure § 1281 4

Other Authorities

California Rules of Professional Conduct
Rule 3-310 9-10

United States Constitution
Article I, Section 8, clause 3 7

INTRODUCTION

The supplemental brief submitted by respondent Brown & Bain (B&B) is based on a number of grossly erroneous assertions. Accordingly, petitioner Theis Research, Inc. (Theis) submits this supplemental brief in response.

This case is closely related to *Buckeye Check Cashing, Inc., v. Cardegna*, No. 04-1264. This case and *Buckeye* both raise the fundamental question of whether an arbitration clause is effective when embedded in a contract that is illegal under state law applicable to contracts generally. B&B does not dispute:

- that B&B had multiple conflicts of interest in the underlying patent litigation;
- that California conflict-of-interest law barred B&B from entering into the legal services agreement without first obtaining Theis' informed written consent; and
- that B&B neither sought nor obtained Theis' informed written consent to B&B's conflicts of interest.

For the reasons already addressed in Theis' reply and noted in the amicus brief filed by Theis in *Buckeye*, the common issue should be examined in the context of this case as well as *Buckeye*. However, this case is not distinguishable from *Buckeye* as argued in B&B's supplemental brief.[1]

---

[1] B&B claims that it filed its supplemental brief to respond to the discussion in Theis' reply concerning the relationship of this case to *Buckeye*. However, B&B's "supplemental" brief is, in effect, a second brief in opposition, attempting to answer the nullity of an arbitration award arising from an unlawful underlying agreement, the applicability of the Federal

ARGUMENT

1.a. In an attempt to sidestep the ineffectiveness of the arbitration clause in its (unlawful) legal services agreement, B&B simply disregards the record. B&B's assertion, that the purported authority of the arbitrator was not premised on the arbitration clause set forth at section 14 of B&B's legal services agreement, is erroneous.

Theis' complaint in arbitration was explicitly predicated on the arbitration clause in B&B's written legal services agreement. The complaint was addressed to B&B on January 12, 1996, nearly three years before anyone has ever contended that Theis was given any "notice" of B&B's PacTel Cellular conflict by virtue of arbitration discovery exchanged in late 1998.[2] The complaint is headed:

> Re: Demand for arbitration under § 14 of the legal services agreement between Theis Research, Inc. and Brown & Bain dated October 30, 1992 and August 20, 1993.[3]

Arbitration Act, and the void vs. voidable distinction—all of which were discussed in the petition (starting with the first question presented). The underlying decision of the Florida Supreme Court in *Buckeye* was itself cited in Theis' petition. *Id.* at 25. B&B did not file its supplemental brief until nearly two months after Theis filed its reply—and several weeks after B&B received Theis' amicus brief in *Buckeye*.

[2] ER 7 at 17; 36 at 17. Arbitration was postponed pending an appeal in the underlying patent litigation.

[3] B&B's petition to confirm the arbitration award states that the legal services agreement was amended on August 20, 1993, to add Peter F. Theis as a party to the agreement. Record, 36 at 32 (¶ 6).

ER 7 at 17; 36 at 17. It then begins as follows:

> Peter F. Theis ("Theis") and Theis Research, Inc. ("TRI"), parties to the referenced legal services agreement dated October 30, 1992 and August 20, 1993 among TRI, Theis and Brown & Bain ("B&B"), which contains a provision for arbitration, hereby demands [*sic*] arbitration thereunder.

Id. Under the heading "**Arbitration Provision**," the complaint then quotes in full all five paragraphs of section 14 of the legal services agreement. ER 7 at 17-18.

Next, the arbitration award itself states that the arbitration occurred pursuant to the arbitration clause in the purported legal services agreement. It begins by stating:

> Pursuant to ¶14 of an Agreement for legal services dated October 30, 1992 and August 20, 1993, Peter F. Theis and Theis Research, Incorporated ("TRI") and Brown & Bain, P.A. ("B&B") have agreed to submit certain disputes to arbitration.

ER 13 at 6. *Accord* ER 13 at 8 (same purported authority recited in arbitrator's statement of reasons).

Further, even B&B's own petition to confirm the arbitration award is premised on the authority purportedly conferred by the arbitration clause:

> On October 30, 1992, Brown & Bain and [Theis] entered into a legal services agreement (the "Agreement") under which Brown & Bain agreed to represent [Theis] in

> certain litigation. Paragraph 14 of the Agreement provided for the arbitration of any and all disputes arising under the Agreement.

Record, 36 at 31 (¶ 5); *see also id.* at 34-45 (attached copy of legal services agreement).

Moreover, in its appellee's brief to the Ninth Circuit, B&B acknowledged that Theis presented its claims against B&B "pursuant to an arbitration clause in their Representation Agreement . . .." Appellee's br. at 5.

In sum, the record establishes unequivocally that the arbitration award was premised on the arbitration clause embedded in the putative legal services agreement.

1.b. B&B argues that—"regardless of whether the legal services agreement was void, voidable, or fully enforceable"—the arbitrator's authority could instead be predicated on an unwritten, implied "consent" to arbitration through participation (even though induced by a putative, but in fact unlawful, underlying agreement). This argument is not only against the record, it is contrary to authority.

The Federal Arbitration Act flatly forecloses B&B's argument. Under the FAA's express terms, an arbitrator's authority must be predicated on a "written" provision or an agreement that is "in writing." 9 U.S.C. § 2. California arbitration law is also predicated on a "written" agreement. Cal. Code Civ. Proc. § 1281. *See* pet. at 27 n.41.[4]

---

[4] The Ninth Circuit's decision is even premised on Theis' having asserted in arbitration its challenge to the legal services agreement as void *ab initio*. App., 13a. The petition (at 7-14) contrasts the record with the Ninth Circuit's decision.

B&B cites two Ninth Circuit decisions, *Ficek v. Southern Pacific Co.*, 338 F.2d 655 (9th Cir. 1964), and *Nghiem v. NEC Electronic, Inc.*, 25 F.3d 1437 (9th Cir. 1994), but both are inapposite. In both *Ficek* and *Nghiem*, the Ninth Circuit did not purport to apply any rule of law derived from either the Federal Arbitration Act or state law, but rules derived from federal labor law.[5]

---

[5] *Ficek* concerned the scope of an arbitration clause in a collective bargaining agreement. 338 F.2d at 656-657. No question was raised as to the validity of the written collective bargaining agreement or its arbitration clause. The question was whether the disputed issue fell within the scope of the clause, and the court found that it did. *Id.*

Nghiem involved an employment dispute. The court found that a written arbitration provision in an employer's policies constituted a written agreement though not signed by the employee. 25 F.3d at 1439-1440. The court also asserted that proceeding with arbitration implied an agreement, but for this theory it relied entirely on three labor cases. *Id.* at 1440 (citing *Piggly Wiggly Operators' Warehouse, Inc. v. Piggly Wiggly etc. Truck Drivers Union, Local No. 1*, 611 F.2d 580 (5th Cir. 1980); *Fortune, Alsweet & Eldridge, Inc. v. Daniel*, 724 F.2d 1355 (9th Cir. 1983); *Teamsters Local Union No. 764 v. J.H. Merritt and Co.*, 770 F.2d 40 (3d Cir. 1985)). Although the appellant invoked the FAA, the Ninth Circuit did not. *Id.* at 1439-1440.

Furthermore, even under *Nghiem*, the scope of implied arbitral authority is limited to the precise issue submitted. *Id.* at 1440. Thus, even accepting the Ninth Circuit's assertion that B&B's conflicts of interest were raised in a challenge to the legal services agreement as void *ab initio* (*see* n.5, *supra*), consent to arbitration under the putative agreement cannot by implied when it is under challenge.

Federal common law governing arbitrations to resolve labor relations disputes provides no authority controlling in either this case or *Buckeye*.[6] B&B did not purport to render legal services pursuant to a putative collective bargaining agreement.

2. B&B advances the extraordinary and unsupported argument that this case does not concern the Federal Arbitration Act (FAA), suggesting that this Court is powerless to review the Ninth Circuit's decision below.[7] B&B cites the incorporation of California law in the putative legal services agreement.[8] Application of the FAA and state law to arbitration questions, however, is not mutually exclusive. *See, e.g., First Options of Chicago, Inc. v. Kaplan*, 514 U.S. 938, 944 (1995); *Rosenthal v. Great Western Financial Securities Corp.*, 14 Cal. 4th 394, 416 (1996).

---

[6] *Cf. Allis-Chalmers Corp. v. Lueck*, 471 U.S. 202, 209 (1985) (§ 301 of the Labor Management Relations Act of 1947, 29 U.S.C. § 185, is "a congressional mandate to the federal courts to fashion a body of federal common law to be used to address disputes arising out of labor contracts"); *Textile Workers Union of America v. Lincoln Mills*, 353 U.S. 448, 456-457 (1957).

[7] Even under B&B's new erroneous theory, the Ninth Circuit's refusal to apply California law by itself presents a federal question under the Rules of Decision Act, 28 U.S.C. § 1652.

[8] B&B also cites the reference to procedural rules of the American Arbitration Association (AAA). Notwithstanding B&B's assertion that AAA procedural rules controlled, the reference to such rules in the arbitration clause was only supplemental and subject to a number of other specific provisions (concerning arbitrator selection, prohibition against ex parte contact, discovery, evidence, and expedited proceedings). ER 7 at 18; 41 at 52.

Applicability of the FAA does not depend on the express incorporation of the FAA in the text of an arbitration clause. This Court has already declared the broad reach of the FAA. *Citizens Bank v. Alafabco, Inc.*, 539 U.S. 52, 56 (2003)(FAA encompasses "'the full reach of the Commerce Clause'").[9]

B&B's argument is novel, even among its own contentions in this litigation. B&B invoked the FAA in the very title of its "Petition for Confirmation of Arbitration Award (9 U.S.C. § 9)." Record, 36 at 31. B&B expressly based its motion to confirm the award on the provisions of the FAA. Record, 35 at 1-9 (every single page of B&B's motion to confirm cites at least one section of the FAA).

If the Ninth Circuit's decision in this case were not subject to resolution through interpretation of the FAA, then there is no governing law at all under which the Ninth Circuit could have purportedly made its decision. The Ninth Circuit certainly did not purport to make its decision under California law.

3. The district court erred by failing to vacate the arbitration award, which arose from an underlying agreement that was an unlawful—and therefore void

---

[9] The applicability of the FAA as a matter of law to an arbitration clause subject to contractual incorporation of both state law and AAA procedures was illustrated in a recent California decision. *Hotels Nevada, LLC v. Bridge Banc, LLC*, 130 Cal. App. 4th 1431 (2005). Affirming an order denying a petition to compel arbitration, the court held that an arbitrator properly deferred for judicial determination a question of whether the underlying agreement was unlawful—thus voiding the purported contract and the embedded arbitration clause—and that this was proper under the FAA. *Id.* at 1433.

ab initio—under state law. The Ninth Circuit failed to correct the district court's error of law, not even addressing the district court's erroneous assertion that the unlawful legal services agreement was "voidable, not void." A favorable determination by this Court of either of the first two questions presented by the petition would—at a minimum—be a sufficient basis to remand to the Ninth Circuit for consideration of whether the district court's assertion was error, although the error is obvious upon any plain reading of California law.

The district court refused to apply the plain language set forth in California precedents vacating arbitration awards arising out contracts entered into illegally by an unlicensed contractor and by an unlicensed broker.[10]

Instead, without any authority, the district court created a Lawyers Exception in conflict with California law.

Under California law, an agreement in violation of the Rules of Professional Conduct is unlawful and unenforceable. *Kallen v. Delug*, 157 Cal. App. 3d 940, 948-949, 951 (1984). "[A]n illegal contract is void . . . " (*id.* at 948, n.2)—not merely voidable.

---

[10] *Loving & Evans v. Blick*, 33 Cal.2d 603, 610-612 (1949); *All Points Traders, Inc. v. Barrington Associates*, 211 Cal.App.3d 723, 738 (1989).

The California Rules of Professional Conduct that barred B&B's representation of Theis stand on just as strong a legal footing as the broker and contractor licensing requirements. *See Chambers v. Kay*, 29 Cal. 4th 142, 158 (2002)(conduct rules "'protect the public . . . '"; giving effect to a purported agreement violating the rules "would be untenable . . . ").

An unlawful representation, undertaken in violation of the rules, cannot be converted retroactively into a lawful representation. Informed written consent to a conflicting representation is a precondition to proceeding with a representation in compliance with the rules. Cal. R. Prof. Conduct 3-310(C)(3). The district court, however, attempted to mutate the provision for informed written consent into a possibility for an after-the-fact waiver of the violation of the rules against conflicts of interest, and from there asserted that an agreement in violation of the rules was "voidable, not void." Furthermore, the district court premised such "waiver" on implication—without any written consent purportedly satisfying the rules.

Soon after the district court's judgment, the California Supreme Court held that where the Rules of Professional Conduct require informed written consent, such consent cannot be given in any other way. *Chambers v. Kay*, 29 Cal. 4th at 155-156. The California Supreme Court also foreclosed any argument that such consent could be inferred from a purported waiver. In *Chambers*, lawyers jointly representing a client entered into a fee-splitting agreement without obtaining the requisite informed written consent of their client. The California Supreme Court rejected a nearly identical attempt to confuse "waiver" with "consent." Even though the client did not object after being provided a copy of a writing memorializing the purported agreement, the California Supreme Court held this could not satisfy the rule requirement of informed written consent by the client. *Id.* at 146, 155-156, 158. The Ninth Circuit decided not to address this. *Cf.* 9th Cir. appellant's br. at 3, 33-35, 45, & reply br. at 1-2, 15-16.

As noted in the reply, although informed written consent—if given in the midst of a conflicted representation—might legitimize the representation going

forward, it cannot change the fact that the representation up to that point was unlawful and therefore void. There is a distinction between (a) *ex ante* informed written consent—which Cal. R. Prof. Conduct 3-310(C) permits, and (b) *ex post facto* waiver of an unlawful contract—which California law does *not* permit. *City Lincoln-Mercury Co. v. Lindsey*, 52 Cal. 2d 267, 274 (1959); *International Assn. of Fire Fighters v. City of San Leandro*, 181 Cal. App. 3d 179, 182 (1986). Moreover, there is no dispute that Theis never gave any informed written consent to B&B's conflicts of interest.

CONCLUSION

This case is not distinguishable from *Buckeye* as argued by B&B.

Theis requests that the petition be granted for plenary review at this time. In the alternative, Theis requests grant and hold pending the Court's decision in *Buckeye*.

Respectfully submitted,

PAUL R. JOHNSON
Counsel of Record
ROBERT D. EASSA
FILICE BROWN EASSA & MCLEOD LLP
1999 HARRISON STREET, 18TH FLOOR
OAKLAND, CA 94612
(510) 444-3131

(6)

FILED
FEB 23 2006
OFFICE OF THE CLERK

No. 04-1566

In the Supreme Court of the United States

THEIS RESEARCH, INC.,

Petitioner,

v.

BROWN & BAIN
and such present and former Brown & Bain partners, associates, and other personnel responsible for the management and trial of all litigation involving Peter F. Theis and Theis Research, Inc.,

Respondent.

On Petition for a Writ of Certiorari
to the United States Court of Appeals for the Ninth Circuit

PETITIONER'S 2nd SUPPLEMENTAL BRIEF

PAUL R. JOHNSON
Counsel of Record
ROBERT D. EASSA
FILICE BROWN EASSA & MCLEOD LLP
1999 HARRISON STREET, 18TH FLOOR
OAKLAND, CA 94612
(510) 444-3131

Counsel for Petitioner

Becker Gallagher Legal Publishing, Inc. 800.890.5001

Rule 29.6 Statement: As stated in the petition, there is no parent or publicly held company owning 10% or more of the stock of petitioner Theis Research, Inc.

TABLE OF AUTHORITIES

Cases

Buckeye Check Cashing, Inc. v. Cardegna
546 U.S. ___ (2006)(No. 04-1264) 1-2

First Options of Chicago, Inc. v. Kaplan
514 U.S. 938 (1995) 3

Theis Research, Inc. v. Brown & Bain
240 F.3d 795 (9th Cir. 2001) 2

Theis Research, Inc. v. Brown & Bain
400 F.3d 659 (9th Cir. 2005) 3

Statute

9 U.S.C. § 10 3

Petitioner Theis Research, Inc. (Theis) submits this second supplemental brief in light of the Court's decision on February 21, 2006, in *Buckeye Check Cashing, Inc. v. Cardegna*, 546 U.S. ___ (2006)(No. 04-1264). Two issues unresolved in *Buckeye* are ripe for determination here.

The first issue is whether courts or arbitrators decide if the parties had the authority and the capacity to enter into the underlying agreement. *See Buckeye*, slip op. at 3 n.1. In this case, under applicable state law, respondent law firm Brown & Bain had no lawful authority or capacity to enter into *any* legal services agreement to represent Theis in the underlying litigation, given the firm's conflicts of interest and its failure to obtain Theis' informed written consent.

The second issue is whether courts have authority, *after* a matter has been arbitrated, to address illegality and invalidity of an underlying putative contract that has an embedded arbitration clause.

The combined effect of the Court's decision in *Buckeye* and the Ninth Circuit's decision in this case—unless this Court reverses the Ninth Circuit's decision—is that courts will *never* be permitted to review the illegality of an underlying agreement. Unlike *Buckeye*, this case arises post-arbitration. The Ninth Circuit concluded that once an arbitrator decides the validity of the underlying agreement, the issue is not open for judicial determination.

As discussed in Theis' amicus brief in support of neither party in *Buckeye*, even if a party must first go to arbitration, a party is entitled to have its illegality challenge to a putative contract decided finally—at some point—by a court rather than an arbitrator. Otherwise, if courts ignore illegality and confirm awards arising from unlawful agreements, courts would become the silent partners of

those who would misuse arbitration to perpetrate unlawful conduct through illegal contracts.

The petitioner in *Buckeye* asserted in its answering brief to the Florida Supreme Court that post-arbitration determination of illegality by a court reviewing an arbitration award would assure against the misuse of arbitration to perpetrate unlawful conduct. Buckeye Check Cashing, Inc. cited the Ninth Circuit's first decision in *Theis Research, Inc. v. Brown & Bain*, arguing that:

> The simple answer to [respondents Cardegna and Reuter's] imaginative hypothetical concerning a contract to purchase and sell drugs that contained an arbitration provision, [br. citation], is that assuming there is no specific attack on the making of the arbitration agreement, the dispute would be directed to arbitration. Presumably, no arbitrator would enforce the underlying contract, but even if he or she did, a court would not enforce the arbitrator's award. *See, e.g., Theis Research, Inc. v. Brown & Bain*, 240 F.3d 795, 796 (9th Cir. 2001) ("TRI's assertions that the arbitration award was invalid because it was based on an illegal contract are properly resolved in the context of TRI's motion to vacate the award.").

Buckeye's *Answer Br.* to Fla. S. Ct. at 17 n.2.

In its current decision, however, the Ninth Circuit has reversed course, holding (erroneously) that presenting the illegality challenge to an arbitrator bars courts from thereafter deciding the issue.

> **Theis submitted to the arbitrator the issue whether B&B's alleged conflicts of interest rendered the Theis-B&B legal services agreement void *ab initio*. The arbitrator rendered a decision on this issue adverse to Theis. The district court thus did not err when it determined that Theis was barred from relitigating the same issue as part of its federal court malpractice claims.**

Theis Research, Inc. v. Brown & Bain, 400 F.3d 659, 666 (9th Cir. 2005). The court's judgment should be reversed.

Contrary to the Ninth Circuit's opinion, this Court's decision in *First Options of Chicago, Inc. v. Kaplan*, 514 U.S. 938, 946-947 (1995), indicates that arguing an issue of arbitrability to an arbitrator is not an obstacle to subsequent judicial determination of the issue.

The validity of an underlying agreement with an arbitration clause concerns the authority of the arbitrator and, therefore, should be decided *de novo* by a court upon application to vacate an award. The Federal Arbitration Act requires that courts vacate *ultra vires* awards—"where the arbitrators exceeded their powers, ..." 9 U.S.C. § 10.

Theis respectfully requests that its petition for a writ of certiorari be granted for plenary review.

Respectfully submitted,

PAUL R. JOHNSON
Counsel of Record
ROBERT D. EASSA
FILICE BROWN EASSA & MCLEOD LLP
1999 HARRISON STREET, 18TH FLOOR
OAKLAND, CA 94612